1873

Jany 21 - Judge Davis

Affirmed -

Judge Clifford

Dissents

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. 451.

THE GROVER & BAKER SEWING-MACHINE COMPANY, THE WHEELER & WILSON MANUFACTURING COMPANY, AND THE SINGER MANUFACTURING COMPANY, PLAINTIFFS IN ERROR,

vs.

THE FLORENCE SEWING-MACHINE COMPANY.

IN ERROR TO THE SUPREME JUDICIAL COURT OF THE STATE OF MASSACHUSETTS.

FILED JULY 16, 1873.

Oct-Y 1873

SUPREME COURT OF THE UNITED STATES.

No. 451.

THE GROVER & BAKER SEWING-MACHINE COMPANY, THE WHEELER & WILSON MANUFACTURING COMPANY, AND THE SINGER MANUFACTURING COMPANY, PLAINTIFFS IN ERROR,

vs.

THE FLORENCE SEWING-MACHINE COMPANY.

IN ERROR TO THE SUPREME JUDICIAL COURT OF THE STATE OF MASSACHUSETTS.

INDEX.

	Original.	Print.
Writ of attachment	3	1
Plaintiffs' declaration	8	3
Exhibit A	15	4
B	27	7
C	32	8
Bill of particulars	35	8
Answer of the Grover & Baker Sewing Machine Company	39	10
Wheeler & Wilson Manufacturing Company	46	12
Singer Manufacturing Company	49	13
Petitions for removal to United States court	53	14
Bill of exceptions	85	22
Verdict	87	23
Disclaimer	88	23
Exceptions	91	24
Judgment	112	40
Clerk's certificate	113	40
Bond	114	40
Citation	115	41
Writ of error	117	42
Clerk's certificate	118	42

1 COMMONWEALTH OF MASSACHUSETTS,
Hampshire, ss:

At our supreme judicial court began and holden at Northampton within and for the county of Hampshire aforesaid, on the third Tuesday of April, being the fifteenth day of said month, in the year of our Lord one thousand eight hundred and seventy-three, by the honorable Reuben A. Chapman, chief justice of said court, and from day to day, on the sixteenth day of said month, and on the seventeenth day of said month, in the year of our Lord one thousand eight hundred and seventy-three, by the Hon. Reuben A. Chapman, chief justice of said court.

2 THE FLORENCE SEWING-MACHINE Company, a corporation established under the laws of the Commonwealth of Massachusetts, and having a usual place of business at Northampton, in the county of Hampshire, and said commonwealth, plaintiff,

versus

THE GROVER & BAKER SEWING-MACHINE Company, a corporation established under the laws of said commonwealth, having a usual place of business at Boston, in our county of Suffolk; The Wheeler and Wilson Manufacturing Company, a corporation established under the laws of the State of Connecticut, and having a usual place of business in said Boston, and The Singer Manufacturing Company, a corporation established under the laws of the State of New York, having a usual place of business at said Boston, defendants.

In an action of contract as by writ, following.

3 COMMONWEALTH OF MASSACHUSETTS, *Hampden, ss:*

L. S.] To the sheriffs of our several counties or their deputies, greeting:

We command you to attach the goods or estate of The Grover and Baker Sewing-Machine Company, a corporation established under the laws of said commonwealth, having a usual place of business at Boston, in our county of Suffolk; The Wheeler and Wilson Manufacturing Company, a corporation established under the laws of the State of Connecticut, and having a usual place of business in said Boston, and The Singer Manufacturing Company, a corporation established under the laws of the State of New York, having its usual place of business at said Boston, to the value of seventy thousand dollars, and to
4 summon the said Grover & Baker Sewing-Machine Company, Wheeler & Wilson Manufacturing Company, and Singer Manufacturing Company, (if they may be found in your precinct,) to appear before our justices of our supreme judicial court next to be holden at Northampton, in our County of Hampshire, on the third Tuesday of April next, then and there in our said court to answer unto The Florence Sewing-Machine Company, a corporation established under the laws of said Commonwealth of Massachusetts, and having a usual place of business at Northampton, in an action of contract, to the damage of the said plaintiff (as it says) the sum of seventy thousand dollars,

which shall then and there be made to appear, with other due damages. And have you there this writ, with your doings therein.

5 Witness Reuben A. Chapman, esquire, at Springfield, the seventh day of January, in the year of our Lord one thousand eight hundred and seventy-one.

GEO. B. MORRIS, *Clerk.*

JAN'Y 7, 1871.

HAMPDEN, *ss:*

Personally appeared A. L. Soule, in behalf of the plaintiff, and made oath that the matter sought to be recovered in this action actually equals and exceeds in amount or value the sum of one thousand dollars. Before me.

E. H. LATHROP,
Justice of the Peace.

BOSTON, *January, 9th,* 1871.

SUFFOLK, *ss:*

By virtue of this writ I this day attached twenty-five sewing-Machines as the property of the within-named Wheeler & Wilson

6 Manufacturing Company, and summon'd said company to appear and answer at court by giving a summons in hand to H. C. Hayden, agent of said company.

BENJ. F. BAILEY,
Dept. Sheriff.

BOSTON, *Jan'y 9th,* 1871.

SUFFOLK, *ss:*

By virtue of this writ I this day, at 30 m. past one o'clock p. m., attached all the right, title, and interest the within-named Grover & Baker Sewing-Machine Company has in and to any and all real estate in the county of Suffolk, and summoned the said company to appear and answer at court by giving a summons in the hand to William O. Grover, the duly authorized agent, and the treasurer of said company.

BENJ. F. BAILEY,
Dept. Sheriff.

7 BOSTON, *January 9th,* 1871.

SUFFOLK, *ss:*

By virtue of this writ I this day attached twenty-five sewing-machines as the property of the within-named Singer Manufacturing Company, and summoned said company to appear and answer at court by giving a summons in hand to Zenas Bangs, esq., agent of said company.

BENJ. F. BAILEY,
Dept. Sheriff.

I certify that the expenses taxed in my returns on this writ have been incurred, and that the same are reasonable.

BENJ. F. BAILEY.

Sworn to before me.

EDWARD H. HALL,
Justice of the Peace.

This writ was returned and entered in this court at the term thereof, holden as aforesaid, on the third Tuesday of April, A. D. 1871, when the plaintiff appeared by its attorney, A. L. Soule, esq., and filed the
8 following declaration and bill of particulars:

Supreme judicial c't, April t'm, 1871.

THE FLORENCE SEWING-MACHINE COMPANY
vs.
THE GROVER & BAKER SEWING-MACHINE CO. & others.

Plaintiff's declaration.

And the plaintiff says that the defendants and the plaintiff made an agreement together in writing, a copy of which, marked A, is hereto annexed, in and by which agreement the defendants, for a valuable consideration, licensed the plaintiff to manufacture, use, and vend for use certain inventions described in certain letters-patent of the United States, in said agreement named, so far as the said inventions, any of them, are contained in certain specimen sewing-machine deposited by the plaintiff with the defendants, at and for a patent rent of five
9 dollars for each sewing-machine which should be made or sold under said agreement for use in the United States, and two dollars for each machine made under said agreement, and actually exported for use in foreign countries and not returned to the United States, which rent was to be paid quarter-yearly, as in said agreement set forth, in accordance with certain quarter-yearly accounts to be rendered by the plaintiff to the defendants, through the receiver in said agreement named. And the defendants by said agreement undertook, and agreed with the plaintiff, that no other license for a drop-feed shuttle sewing-machine using two threads should thereafter be granted by the defendants under the patents in said agreement named, at a less
10 patent rent for machines without a corresponding reduction in the patent-rent in said agreement reserved. And said agreement was on the first day of Oct., A. D. 1868, and for a long time previous thereto had been, and is still, in force and binding on the defendants. And the defendants after the making thereof, to wit, on the 1st day of Oct. A. D. 1868, by their agreement in writing, a copy of which is hereto annexed, marked B, granted a license under said patents to one The Davis Sewing-Machine Company for the sum of twenty thousand dollars, to manufacture, use, and vend for use, any number not exceeding fifty thousand drop-feed shuttle sewing-machine' using two threads. And afterward, to wit, on the sixth day of April, 1867, the defendants by their instruments in writing, a copy of which is hereto annexed, marked C, assented to the assignment by the Davis Sewing-Machine Company aforesaid, of said license to the Davis Sewing-
11 Machine Company of Watertown, New York, and under said license large numbers of drop-feed shuttle sewing-machines using two threads, have been made by said Davis Sewing-Machine Company, and its assigns; and by reason of the granting of said license by the defendants to the Davis Sewing-Machine Company, the plaintiff was entitled to a corresponding reduction in the patent-rent reserved in its agreement aforesaid with the defendants, that is to say, a reduction to a rent of forty cents for each and every sewing-machine made or sold under said agreement, which last-named rent is at the rate of twenty

thousand dollars for fifty thousand machines. But the defendants neglected to inform the plaintiff that they had granted said license to the Davis Sewing-Machine Company and neglected to inform
12 the plaintiff that the patent rent under said agreement with the plaintiff was reduced in any way, or that the plaintiff was entitled to a reduction thereof, but left the plaintiff in ignorance of said license and said reduction, and continued to demand and receive from the plaintiff patent-rent at the rate of two dollars for exported machines and five dollars for *for* domestic, that is to say, non-exported machines, made or sold under said agreement of the defendants and the plaintiff; and the plaintiff being ignorant of the granting of said license to the Davis Sewing-Machine Company, and being ignorant of any reduction in the patent-rent reserved in the said agreement with the defendants, continued to pay patent-rent to the defendants, through their said receiver, on sewing-machines made
13 after the said license was granted by the defendants to said Davis Sewing-Machine Company, and so paying, paid in ignorance of its rights, to the defendants, through their receiver, a large sum, to wit, the sum of fifty-eight thousand six hundred and twenty-seven dollars and sixty cents, above and in addition to all sums which the plaintiff was under obligations to pay as said patent-rent, under said agreement of the plaintiff with the defendants, as modified by the granting of said license to said Davis Sewing-Machine Company, as aforesaid, and in addition to all sums which the defendants were entitled to demand, claim, or receive of or from the plaintiff under its said agreement with them, as modified as aforesaid, and said amount, so overpaid, was afterward diminished by the sum of seven thousand and fourteen dol-
14 lars and forty cents, being the patent-rent at forty cents per machine, on seventeen thousand five hundred and thirty-six machines, sold by the plaintiff after said overpayment was made, and before the plaintiff sued out its writ herein, and for which such rent should have been due and payable if such overpayment had not been made; and the defendant's owe the plaintiff the sum of fifty-one thouand six hundred and thirteen dollars and twenty cents, for the moneys so overpaid them by the plaintiff, and the balance thereof with interest thereon.

Also the plaintiff says that the defendants owe it the sum of sixty thousand dollars for money had and received by the defendants to the use of the plaintiff.

15 THE FLORENCE SEWING-MACHINE CO.,
By A. L. SOULE, *its Att'y.*

A.

Articles of agreement made this twentieth day of February, 1868, by and between the "Wheeler & Wilson Manufacturing Company," the "Grover & Baker Sewing-Machine Company," and the "Singer Manufacturing Company," parties of the first part, and the Florence Sewing-Machine Company, of the second part, as follows:

First. The parties of the first part, in consideration of the patent-rent herein reserved and the covenants herein contained, do, according to their respective rights and powers so to do, severally authorize
16 and license said parties of the second part to manufacture, use, and vend for use, the inventions contained and described in the re-issued letters-patent to Allen B. Wilson, Nos. 346 and 414, dated, respectively, January 22d, 1856, and December 9th, 1856; to John Bachelder, No. 2125, dated December 12th, 1865; the letters-patent to A. B.

Ely, as assignee of Jotham S. Conant, No. 12233, dated January 16th, 1855; the letters-patent to W. P. N. Fitzgerald, No. 12116, dated December 19th, 1854; the re-issued letters-patent to Reuben G. Fairbanks, assignee of Akins & Felthousen, No. 9030, dated April 11th, 1865; the sixth claim of the re-issued letters-patent to the Wheeler & Wilson Manufacturing Company, No. 913, dated February 28th, 1860; and so much of the letters-patent of the Grover & Baker Sewing-Machine Company, No. 9053, dated June 22d, 1852, as relates to the feeding-
17 mechanism; the letters-patent to Isaac M. Singer, No. 16030, dated November 4th, 1856, and the first claim in the letters-patent to Isaac M. Singer, No. 12969, dated May 29th, 1855; the fourth claim in the re issued letters-patent to said Singer, No. 278, dated October 3d, 1854, and the claim for controlling the needle-thread in the patent to said Singer, No. 10974, dated May 30th, 1854, so far as the same or any of them are contained in the specimen sewing-machines this day deposited with the receiver of the licensers, and marked Florence machine and McCauley machine and Jencks machine, and in the form in which said inventions are embodied in said specimen machine, and not otherwise, except said McCauley machine may also be made with a drop-feed.

Also to make, use, and vend, in connection with machines like said specimen machines, the inventions described and contained in the following letters-patent:

18 Those to Sherburne C. Blodgett, No. 10386, dated January 3d, 1854; to John B. Nichols, No. 11615, dated August 29th, 1854; to Seth P. Chapin, No. 14283, dated February 19th, 1856; to Geo. C. Munson, No. 181, dated January 22d, 1861.

And said licensers also, respectively, agree that they will not, while this agreement remains in force, and is performed on the part of said licensees, make any further claim of license fees from said licensees under any other patents which they now or may hereafter own or control, covering any of the devices embodied in said specimen machines.

Second. The patent-rent shall be five dollars for each and every sewing-machine which shall be made or sold under this license by said licensee while this license remains in force, and the prompt payment thereof shall be at all times adequately secured by said licensee.

19 Third. Said licensees hereby agree not to make or be interested in making or selling the inventions above enumerated, or any of them, in any other form than the same are now embodied in the specimen machine above refer'ed to, nor upon any other machines. And that they will not contest or encourage or promote litigation against the sewing-machine patents now belonging to any of said licensers, or which shall hereafter belong to any of them.

Fourth. Said licensees agree to manufacture said sewing-machines at their manufactory in Florence, Massachusetts, and nowhere else, without the written consent of said licensers, and to stamp each machine as the law requires before sale with the word "patented," the dates of the patents embraced therein, and with the Florence Sewing-Machine Company's name as makers, and to number each machine consecu-
20 tively, beginning with number ; and to keep in suitable books a true account of all machines made or sold under this license, and to allow either of said licensers or their agents for that purpose to fully examine, upon reasonable request, all departments of said manufactory, and all books pertaining to said account; each machine to be entered in said book or books, as fast as completed or sent from the manufactory.

Fifth. Said licensees hereby agree to render to said licensers, or to such person as they shall appoint to receive the same, quarter-yearly, from January 1st, 1868, a true and full account, in writing, of all sewing-machines made or sold by said licensees during each quarter successively while this license continues. Said returns to contain the number of machines made or sold, date of sale, and to be verified by the oath
21 of said licensees, or the employee having the best means of knowing the truth thereof; and on or before the tenth day of July, October, January, and April, of each successive year, said licensees agree to pay said licensers, or their duly-authorized receiver, the said patent-rent for each and every sewing-machine which shall have been made or sold by said licensees during the last preceding quarter-year, and which shall not have been before paid for.

Sixth. It is agreed and understood that this license is personal to said licensees, and is not in any way to be divided or assigned or shared with others, without the united written con'ent of all said licensers, and additional security, if required, but with such consent and security, it may enure to the benefit of the legal representatives of said licensees.

Seventh. No other license for a drop-feed shuttle sewing-ma-
22 chine, using two threads, is to be granted by said licensers under the before-mentioned patents at a less patent-rent per machine, without a corresponding reduction in the patent-rent herein reserved; and machines of the same pattern are not to licensed to different parties.

Eighth. Said licensees further agree that they will not make or sell, nor be engaged, directly or indirectly, in the manufacture or sale of any sewing-machine which shall be an imitation or counterfeit, or be made to resemble, in general form and appearance, the design or form of a sewing-machine already licensed and in use by any other licensee under the parties of the first part; and a violation of this provision by the licensees shall, at the election of the licensers, operate ipso facto as a revocation and termination of this license.

23 Ninth. It is agreed and understood that said patent-rent shall be two dollars, instead of five dollars for each machine actually exported for use in foreign countries and not returned to the United States, and satisfactory proof of such exportation and destination of the exported machines shall be furnished to said licensers before such reduction shall be made; and no machine paid for at such reduced rent shall thereby be authorized to be used in the United States under this license.

Tenth. It is agreed that said licensers reserve the right, at their option, to terminate this license upon thirty days' written notice thereof, for breach of any of the agreements herein contained on the part of said licensees; or in case the number of sewing-machines which shall be mad' and paid for, in any quarter-year as aforesaid, shall fall be-
24 low two hundred and fifty; otherwise it shall remain in force until the twelfth day of November, 1871, and as much longer as the licensees elect to continue the same.

Eleventh. It is agreed and understood that said licensees shall not sell or deal in, or al'ow their agents to deal in, any sewing-machines using the hereinbefore-enumerated patents, or any of them, unless th same shall be regularly made under this license, or shall be legally supplied by the licensers, or some of them, or their licensees.

Twelfth. It is agreed and understood that Geo. Gifford, esq., is the authorized receiver of said licensers, until further appointment by them, to receive all reports and accounts of machines at any time made or

sold under this agreement by said licensees, and to receive and retain all machines required by this agreement to be deposited
25 with said licensers, and to collect and receive all sums which by this agreement are to be paid for patent-rent or otherwise, and said licensers shall render such accounts, make such deposit of machines, and make such payments to said Gifford or such other person as said licensers may appoint; and rendering such accounts, and making such payments to and deposit with said Gifford, or such other person as *as* said licensers shall appoint, shall (so far as respects depositing machines, rendering accounts, and making payments) be a compliance with and performance of this agreement by said licensees.

In witness whereof the said parties have executed these presents in duplicate, the day and year first above written.

26 WHEELER & WILSON MANUFACTURING COMP'Y,
By N. WHEELER, *President.*
GROVER & BAKER SEWING-MACHINE COMPANY,
By O. B. POTTER, *President.*
THE SINGER MANUFACTURING COMPANY,
By INSLEE A. HOPPER, *President.*
THE FLORENCE SEWING-MACHINE COMPANY,
W'M B. HALE, *President.*

27 B.

Articles of agreement, made this first day of October, 1868, by and between the "Wheeler & Wilson Manufacturing Company," "The Singer Manufacturing Company," and the Grover & Baker Sewing-Machine Company, parties of the first part, and the "Davis Sewing-Machine Company," party of the second part, witnesseth:

First. The parties of the first part, for the consideration of twenty thousand dollars to them in hand paid, do hereby authorize and license said party of the second part, as herein provided, but not otherwise, to manufacture, use, and vend for use, the inventions described in the letters-patent granted by the United States of America to William H. Johnson, March 7th, 1854, re-issued February 26th, 1856, No. 355, and
28 duly extended April 15th, 1867, upon sewing-machines, not exceeding fifty thousand in number, of the kind and made like the one deposited with said licensers, and marked "Davis Sewing Machine," and no others, which shall be built at their shop in Watertown, New York, and at no other shop or place, without permission in writing first obtained of said licensers.

Second. Said licensees hereby acknowledge the validity of said patent-rights, and the novelty of the inventions thereby secured, and agree not to make or be interested in making or selling the inventions above enumerated, or any of them, in any other form than the same are now embodied in the specimen machine above referred to, nor upon any other machine. And that they will not contest, or encourage, or
29 promote litigation against the sewing-machine patents now belonging to any of said licensers, or which shall hereafter belong to any of them.

Third. Said licensers also respectively agree that they will not while this agreement remains in force, and is performed on the part of said licensees, make any further claim of license-fees from said licensees, under any other patents which they now or may hereafter own or con-

trol for making or selling sewing-machines like said specimen Davis machine.

Fourth. Said licensees agree to manufacture said sewing machines at their manufactory in said Watertown, and nowhere else, without the written consent of said licensers, and to stamp each machine as the law requires before sale, with the word "patented," the dates of the
30 patents embraced therein, and with "Davis Sewing-Machine Company's" name as makers, and to number each machine consecutively, beginning with number one, and to keep in suitable books a true account of all machines made or sold under this license, and to allow either of said licensers, or their agents for that purpose, to fully examine upon reasonable request all departments of said manufactory, and all books pertaining to said account, each machine to be entered in said book or books as fast as completed or sent from the manufactory.

Fifth. It is agreed and understood that the license is personal to said licensees, and is not in way to be divided, or assigned, or shared with others without the written consent of all said licensers, and additional security, if required, but with such consent and security it may
31 inure to the benefit of the legal representatives of said licensees.

Sixth. It is agreed and understood that said licensees shall not sell or deal in or allow their agents to deal in any sewing-machines, unless the same shall be regularly made under this license, or shall be legally supplied by the licensers or some of them, or their licensees.

In witness whereof the said parties have executed these presents in duplicate the day and year first above written.

THE SINGER MANUFACTURING COMPANY,
By INSLEE A. HOPPER, *President.*
GROVER & BAKER SEWING-MACHINE COMPANY,
By O. B. POTTER, *President.*
WHEELER & WILSON MANUFACTURING COMPANY,
By N. WHEELER, *President.*
THE DAVIS SEWING-MACHINE COMPANY,
By J. A. DAVIS, *President.*

32 C.

Whereas a written license for the manufacture and sale of sewing-machines was made and granted by the "Wheeler & Wilson Manufacturing Company," "The Singer Manufacturing Company," and the "Grover & Baker Sewing-Machine Company," to the "Davis Sewing-Machine Company," bearing date the first day of October, 1868; and whereas the parties interested in the said "Davis Sewing-Machine Company" desire to perfect a re-organization in the business of making and selling said sewing-machines, and for that purpose propose to organize a new company or corporation by the name of "The Davis Sewing-Machine Company of Watertown, N. Y.," to carry on said business in the place and stead of the said Davis Sewing-Machine Company:

Now, for value received, the undersigned, said licensers, hereby
33 agree and covenant that the said licensees may assign and transfer the said license, and all its rights and privileges under the same, to the aforesaid new company, to wit: "The Davis Sewing-Machine Company of Watertown, New York," when formed, and that such assignee shall and may possess, hold, and enjoy all the rights and privileges granted in and by said license as fully and completely as the same could be held and enjoyed by the said licensee if no such assignment were made, such assignment to be entire and not divisable, and subject to the conditions in said license contained.

And we hereby acquiesce and consent to the commencement of the numbering the machines under the 4th clause in said license, with "No. 3501" instead of "No. 1."

Dated April 6, 1869.

34 (Signed) GROVER & BAKER S.-M. Co.,
O. B. POTTER, *Pres't.*
WHEELER & WILSON M'F'G Co.,
By N. WHEELER, *Pres't.*
THE SINGER M'F'G Co.,
By INSLEE A. HOPPER, *Pres't.*

35 PLAINTIFF'S BILL OF PARTICULARS.

The Grover & Baker Sewing-Machine Co., The Wheeler & Wilson Manufacturing Co., & The Singer Manufacturing Co., to the Florence Sewing-Machine Co., Drs.

Items.				
1869.				
1.	Jan'y 1–10.	To cash paid Geo. Gifford, receiver		15,569 00
2.	Apr. " "	To cash paid Geo. Gifford, receiver		12,762 00
3.	July " "	To cash paid Geo. Gifford, receiver		15,823 00
4.	Oct. " "	To cash paid Geo. Gifford, receiver		19,758 00
		Total pay't		$63,911 00
		Less:		
1869.				
5.	Jan'y.	Patent-rent on 3,331 machines, at 40 cts	$1,332 40	
6.	April.	Patent-rent on 2,670 machines, @ 40 cts	"1,068 00	
7.	July.	Patent-rent on 3,182 machines, @ 40 cts	1,272 80	
8.	Oct.	Patent-rent on 4,028 machines, at 40 cts	1,611 20	
				$5,283 40
		Amount of overpayment		58,627 60
		Less:		
		Patent-rent, at 40 cts., on machines afterwards sold, and which would have been due and payable at the following dates:		
36 1870.				$58,627 60
9.	Jan'y 10.	On 3,780 machines	$1,512	
10.	Apr. 10.	On 3,675 machines	1,470	
11.	July 10.	On 4,414 machines	1,765 60	
12.	Oct. 10.	On 5,667 machines	2,266 80	
				7,014 40
		Bal. of overpaym't when suit commenced		$51,613 20
13.		With interest to be added.		

And within ten days thereafter, to wit, on the nineteenth day of April, during said term, the said Grover & Baker Sewing-Machine Company filed the following appearance:

I appear for the defendants, The Grover & Baker S.-M. Co., in the above-entitled cause.

ELIAS MERWIN.

And on the 20th day of April, during said term, this further appearance was filed:

37 Allen & Bond, att'ys, appear generally for the above-named

Grover & Baker Sewing-Machine Co., and also appear specially for purpose, meaning to dismiss said action, and other special objections to the jurisdiction of said court, and otherwise to said suit against the said Wheeler & Wilson M'f'g Co. and The Singer Sewing-Machine Co.

ALLEN & BOND.

And it appearing to the court upon the suggestion of the plaintiff's counsel, and on the inspection of the officer's return on plaintiff's writ, that personal property of the said Wheeler and Wilson Manufacturing Company, and of the said Singer Manufacturing Company, defendants, was attached on said writ, and that personal service was made upon the agents of said defendants respectively:

It is now ordered by the court here that the plaintiff give notice to the said Wheeler & Wilson Manufacturing Company and the
38 Singer Manufacturing Company, defendants, of the pendency of this action, by causing an attested copy of this order to be published in the Springfield Republican, a public newspaper printed at Springfield, in our county of Hampden, once a week three weeks successively, the last publication to be thirty days at least before the next term of this court to be holden at Greenfield, in our county of Franklin, and for our counties of Franklin and Hampshire aforesaid, on the Monday next after the second Tuesday of September next, that they may then and there appear and answer thereto, and that this action be continued to the next term of this court as aforesaid, and so from term to term until notice shall be given to the said defendants agreeably to this order.

Attest:

WM. F. STRICKLAND, *Clerk.*

39 And in vacation, to wit, on the 17th day of May, A. D. 1871, the Grover & Baker Sewing-Machine Co. filed the following answer:

FLORENCE SEWING-MACHINE COMPANY
vs.
GROVER & BAKER S.-M. CO. & ALS.

Answer of Grover & Baker S. M. Co.

These defendants come, and for answer say that they, together with the other companies named as defendants, did grant a written license to the plaintiffs, but they cannot say whether the plaintiffs have annexed a true copy thereof to their declaration, and leave the plaintiffs to produce and prove said original. They also admit that they did grant a certain license to the Davis Sewing-Machine Company, but they
are unable to say whether the plaintiffs have annexed a true
40 copy thereof to their declaration, and require the plaintiffs to produce and prove said original license; but these defendants deny that said alleged license to the Davis Sewing-Machine Co. was for a drop-feed shuttle sewing-machine, or that said defendant companies have ever granted any license to said Davis S. M. Co., or to any party or persons whatever, for a drop-feed machine, at any less rate or rent or royalty per machine than that which the plaintiffs agreed to pay in their said license, or by which the plaintiffs are or have been entitled to any deduction or reduction whatever from the same, expressed in

their license aforesaid. And these defendants aver that the plaintiff wrongfully and under the false pretence that the said Davis sewing-machine was a drop-feed machine, according to the intent and
41 meaning of said license, have neglected and refused to pay the sums falling due to said defendant companies, from time to time, under said licence, and are indebted to said licensors in a very large sum, namely, two hundred thousand dollars. And these defendants deny that said licensors, or either of them, concealed or withheld from the plaintiffs the fact that they had granted a license to said Davis S.-M. Co., or that the plaintiffs were ignorant thereof, or that they ever paid any sum whatever to said defendant companies in ignorance of said license, or of any other fact whatever bearing upon their liability and obligations to said defendant companies. And these defendants aver that said alleged payments were made by the plaintiffs, if at all, voluntarily, and with full knowledge of the license to said Davis
42 S.-M. Co., and of said Davis machine, and because said plaintiffs were in law and justice bound to make the same.

And these defendants deny that said defendant companies owe the plaintiffs any sum whatever. And they aver that the plaintiffs are indebted to said defendants on account of said license-fees, which they have unlawfully withheld and refused to pay, in the sum of two hundred thousand dollars.

And these defendants deny every allegation in plaintiffs' declaration not already answered or denied.

By ELIAS MERWIN,
Their Att'y.

This action was continued from said term to the term of this court holden at Greenfield, within our county of Franklin, and for our counties of Franklin and Hampshire, on the Monday next after the
43 second Tuesday of September, 1871, when the following affidavit of compliance with the order of notice to the said Wheeler and Wilson Manufacturing Company and the Singer M'f'g Co. was filed in said court:

I, A. L. Soule, certify that I caused a true and attested copy of the within order of notice to be published, as therein directed, three successive weeks once a week, to wit, July 29th, 1871, and August 5th, 1871, and August 12th, 1871, in the Springfield Republican, within named, and complied in behalf of the plaintiff with the within order.

A. L. SOULE.

FRANKLIN, *ss:*

SEPT. 18.—Subscribed and sworn to before me.

WM P. STRICKLAND,
Justice of the Peace.

This action was thence continued to the term of this court
44 holden at Northampton, within and for said county of Hampshire, on the third Monday of April, A. D. 1872, when Hon. E. R. Hoar appeared for the Florence Sewing-Machine Co., plaintiff, and J. G. Abbott, esq., appeared for said defendants, and on the 16th day of April, during said term, the following motion was filed:

time to time under said license, and are indebted to said licensors in a very large sum on that account.

And these defendants deny that said licensors, or either of them, concealed or withheld from the plaintiffs the fact that they had made the agreement aforesaid with said Davis Company, or that the plaintiffs were ignorant thereof, or that the plaintiffs ever paid any sum whatever to or for the benefit of said licensors in ignorance of said agreement with said David Company, or of any other fact bearing upon their obligations to said licensors, or that the fact of said agreement was material.

52 And the defendants aver that said alleged payments were made by the plaintiffs, if ever, voluntarily, and with full knowledge of the agreement aforesaid with said Davis Manufacturing Company, and of all the facts relating thereto.

These defendants deny that said defendant companies, or either of them, owe the plaintiffs any sum whatever, and they deny every allegation in the plaintiffs' declaration not herein already answered unto.

By ELIAS MERWIN, *the Att'y.*

And on said sixteenth day of April, the said Wheeler & Wilson Manufacturing Company filed the following petition :

53 Supreme judicial court.

HAMPSHIRE, *ss :*

THE FLORENCE SEWING-MACHINE COMPANY
vs.
THE GROVER & BAKER SEWING-MACHINE Company, The Wheeler & Wilson Manufacturing Company, & The Singer Manufacturing Company.

Affidavit on behalf of The Wheeler & Wilson Manufacturing Co.—Petition for removal to U. S. court.

I, Nathaniel Wheeler, of Bridgeport, Conn., president of The Wheeler & Wilson Manufacturing Company, on oath depose and say that the said Wheeler & Wilson Manufacturing Company is one of the defendants in the above-entitled suit, now pending in the supreme judicial court for the county of Hampshire and State of Massachusetts, wherein the said defendant has made a petition for the removal of said

54 cause to the next circuit court of the United States, to be held at Boston, within and for the district of Massachusetts, for the reason that said defendant believes that from prejudice and local influence it will not be able to obtain justice in said State court. And I further depose and say, in behalf of said defendant, that I have reason to believe, and do believe, that from prejudice and local influence *that* the said Wheeler & Wilson Manufacturing Company will not be able to obtain justice in said State court, and I make this affidavit in its behalf for the purpose of removing said suit into the circuit court of the United States for the district of Massachusetts, in the first circuit, in pursuance of the statute of the United States is that behalf made.

NATHANIEL WHEELER.

Subscribed and sworn to before me this 12th day of April, 1872.
[SEAL.] R. B. LACEY,
Notary Public.

55 COMMONWEALTH OF MASSACHUSETTS,
Hampshire, ss :

Supreme judicial court.

THE FLORENCE SEWING-MACHINE COMPANY
vs.
THE GROVER & BAKER SEWING-MACHINE Company, The Wheeler & Wilson Manufacturing Company, & The Singer Manufacturing Company, defendants.

To the honorable the supreme judicial court, begun and holden on the Tuesday of April, A. D. 1872, at Northampton, within and for the county of Hampshire and Commonwealth of Massachusetts.

Your petitioner, The Wheeler & Wilson Manufacturing Company, respectfully represents that it is one of the defendants in the above-entitled suit, now pending in said court, and is a corporation, established by the laws of, and now is, and was at the commencement of said suit, a citizen of the State of Connecticut; and that said
56 plaintiff is a corporation, established by the laws of, and now is, and was at the commencement of the said suit, a citizen of the State of Massachusetts. And your petitioner further shows, that there is, and was at the time when said suit was brought, a controversy therein between a citizen of the State of Massachusetts, namely, the said Florence Sewing-Machine Company, and a citizen of the State of Connecticut, namely, your petitioner, one of the defendants therein; and further, that the said plaintiff claims in the writ and declaration in this suit, as damages against your petitioner, the sum of seventy thousand dollars; and that the matter in dispute in this suit exceeds the sum of five hundred dollars, exclusive of costs.

And your petitioner represents that this suit has not yet been
57 tried, but that the same is pending for trial in this court, at Northampton, within the aforesaid county of Hampshire; and that your petitioner has reason to believe, and does believe, that from prejudice and local influence your petitioner will not be able to obtain justice in said State court, and files herewith an affidavit to that effect in its behalf, a copy of which affidavit is annexed to this petition and made a part thereof; that your petitioner desires to remove this suit, before the trial thereof, into the next circuit court of the United States, at the next term thereof, to be held at Boston, within and for the district of Massachusetts, in the first circuit, in accordance with the acts of Congress in that behalf made and provided; and that your petitioner is ready and willing, and hereby offers, to give such good and sufficient
surity as the law requires for its doing all acts and things required
58 by law to be done, upon the removal of a suit into the United States court, and it offers herewith its bond, executed by its authority and in its behalf, and also by William O. Grover and William E. Baker, both of Boston, in the State of Massachusetts, as its sureties therein in the penal sum of two hundred thousand dollars, conditioned that your petitioner shall enter in the next circuit court of the United States, to be held at Boston, within and for the district of Massachusetts, and the first circuit, on the first day of the session, copies of all process, pleadings, depositions, testimony, and other proceedings in this suit, and doing such other appropriate acts as by the said acts of Congress are required to be done upon the removal of a suit into the

United States court as good and sufficient surety, according to the
59 said provisions of law, upon the removal of a suit unto the United States court.

Your petitioner therefore prays that said bond may be accepted as such good and sufficient surety, according to said provisions of law; and that said suit may be removed into the next circuit court of the United States, to be held at Boston, within and for the district of Massachusetts and the first circuit, pursuant to the statute of the United States in that case made and provided, and that no further proceedings whatever may be had therein in this court.

WHEELER & WILSON MANUFACTURING CO.,
By N. WHEELER, *President.*

And said Wheeler & Wilson Manufacturing Company also filed
60 the following affidavit for removal to the United States circuit court for the district of Mass.:

COMMONWEALTH OF MASSACHUSETTS,
Supreme judicial court, *Hampshire, ss:*

THE FLORENCE SEWING-MACHINE COMPANY
vs.
THE GROVER & BAKER SEWING-MACHINE COMPANY, The Wheeler & Wilson Manufacturing Company, & The Singer Manufacturing Company.

Affidavit on behalf of The Wheeler & Wilson Manufacturing Company for removal to U. S. court.

I, Nathaniel Wheeler, of Bridgeport, Conn., president of The Wheeler & Wilson Manufacturing Co., in behalf of said Wheeler & Wilson Manufacturing Company, on oath depose and say that the said
61 Wheeler & Wilson Manufacturing Company is one of the defendants in the above-entitled suit, now pending in the supreme judicial court for the county of Hampshire and State of Massachusetts, wherein the said defendant has made a petition for the removal of said cause to the next circuit court of the United States, to be held at Boston, within and for the district of Massachusetts, for the reason that said defendant believes that from prejudice and local influence it will not be able to obtain justice in said State court. And I further depose and say, in behalf of said defendant, that I have reason to believe, and do believe, that from prejudice and local influence *that* the said Wheeler and Wilson Manufacturing Company will not be able to obtain justice in said State court, and I make this affidavit in its behalf for the
62 purpose of removing said suit unto the circuit court of the United States for the district of Massachusetts, in the first circuit, in pursuance of the statutes of the United States in that behalf made.

NATHANIEL WHEELER.

Subscribed and sworn to before me this 12th day of April, 1872.
[SEAL.] R. B. LACEY,
Notary Public.

63 And on the same day filed their bond as follows:

Know all men by these presents that we, The Wheeler and Wilson Manufacturing *Manufacturing* Company, a corporation created by

the laws of the State of Connecticut, and situate therein, as principal, and Wil' O. Grover and William E. Baker, both of Boston, in the State of Massachusetts, as sureties, are held and firmly bound unto the Florence Sewing-Machine Company, a corporation created by the laws of and established in the State of Massachusetts, in the sum of two hundred thousand dollars, to the true payment of which sum to the said Florence Sewing-Machine Company, its seccessors and assigns, we hereby bind ourselves, our successors, heirs, executors, and ad-
64 ministrators, sealed with our seals and executed this fifteenth day of April, A. D. 1872.

Whereas a suit was heretofore brought by the said Florence Sewing-Machine Company against the said Wheeler and Wilson Manufacturing Company, and against The Grover and Baker Sewing-Machine Company, a corporation created by the laws of the State of Massachusetts, and The Singer Manufacturing Company, a corporation created by the laws of the State of New York, which said suit was returnable to the April term of the supreme judicial court for the county of Hampshire, in said State of Massachusetts, for the year 1871, and was then entered and is now pending in said court for trial at Northampton, within and for
65 said county, and is removable into the circuit court of the United States for the district of Massachusetts, in the first circuit, under the act of Congress approved March 2, 1867, and the acts to which the said act is in addition and amendatory of;

And whereas the said Wheeler and Wilson Manufacturing Company has filed its petition in said supreme judicial court, and also the affidavit required by said act for the removal of said suit into the next circuit court of the United States, to be held at Boston within and for the district of Massachusetts:

Now, therefore, the condition of the above obligation is such, that if the said Wheeler and Wilson Manufacturing Company shall enter, or cause to be entered, in the circuit court of the United States, to
66 be held at Boston, within and for the district of Massachusetts, on the first day of its stated session next ensuing after the order of the said supreme judicial court for the removal of said suit into said United States circuit court, copies of all process, pleadings, depositions, testimony, and all other proceedings in said suit, and do, or cause to be done, all such other acts and things as by the acts of Congress may be required to be done upon the removal of a suit into the United States court, then the above obligation is to be void; otherwise, to remain in full force and virtue.

WHEELER & WILSON M'F'G CO.,
[L. S.] By N. WHEELER, *Pres't.*
W. O. GROVER. [SEAL.]
W'M E. BAKER. [SEAL.]

In presence of—
ELIAS MERWIN.

67 And on said sixteenth day of April, the said Singer Manufacturing Company filed the following petition for removal to said United States court:

COMMONWEALTH OF MASSACHUSETTS,
Hampshire, ss:

Supreme judicial court.

THE FLORENCE SEWING-MACHINE COMPANY
vs.
THE GROVER & BAKER SEWING MACHINE COMpany, The Wheeler & Wilson Manufacturing Company, & The Singer Manufacturing Company.

Affidavit on behalf of The Singer Machine Company, on petition for removal of suit to U. S. Court.

I, Inslee A. Hopper, of Newark, New Jersey, president and in behalf of said Singer Manufacturing Company, on oath depose and say,
68 that the said Singer Manufacturing Company is one of the defendants in the above-entitled suit now pending in the supreme judicial court for the county of Hampshire & State of Massachusetts, wherein the said defendant has made a petition for the removal of said cause to the next circuit court of the United States, to be held at Boston, within and for the district of Massachusetts, for the reason that said defendant believes that, from prejudice and local influence, it will not be able to obtain justice in said State court. And I further say and depose, in behalf of said defendant, that I have reason to believe, and do believe, that, from prejudice and local influence, the said Singer Manufacturing Company will not be able to obtain justice in said State
69 court, and I make this affidavit in its behalf for the purpose of removing said suit into the circuit court of the United States for the district of Massachusetts, in the first circuit, in pursuance of the statute of the United States in that behalf made.

INSLEE A. HOPPER.

Subscribed and sworn to before me this 13th day of April, 1872.
JAMES MEEHAM, [SEAL.]
Notary Public in and for the City & County of the State of New York.

70 COMMONWEALTH OF MASSACHUSETTS,
Hampshire, ss:

Supreme judicial court.

THE FLORENCE SEWING-MACHINE COMPANY
vs.
THE GROVER & BAKE' SEWING-MACHINE COMpany, The Wheeler & Wilson Manufacturing Company, & The Singer Manufacturing Company, defendants.

To the honorable the supreme judicial court began and holden on the Tuesday of April, A. D. 1872, at Northampton, within and for the county of Hampshire and Commonwealth of Massachusets.

Your petitioner, The Singer Manufacturing Company, respectfully represents that it is one of the defendants in the above-entitled suit now

pending in said court, and is a corporation established by the laws of,
and now is, and was at the commencement of said suit, a citizen
71 of the State of New York, and that said plaintiff is a corporation
established by the laws of, and now is, and was at the commencement of its said suit, a citizen of the State of Massachusetts. And your petitioner further shows that there is and was at the time when said suit was brought a controversy therein between a citizen of the State of Massachusetts, namely, the said Florence Sewing-Machine Company, and a citizen of the State of New York, namely, your petitioner, one of the defendants therein, and further, that the said plaintiff claims in its writ and declaration in this suit, as damages against your petitioner, the sum of seventy thousands dollars, and that the matter in dispute in this suit exceeds the *the* sum of five hundred dollars exclusive of costs.

And your petitioner represents that this suit has not yet been
72 tried, but that the same is pending for trial in this court at Northampton, within and for said county of Hampshire, and your petitioner has reason to believe, and does believe, that, from prejudice and local influence, your petitioner will not be able to obtain justice in said State court, and files herewith an affidavit to that effect, made in its behalf, a copy of which affidavit is annexed to this petition and made a part thereof. That your petitioner desires to remove this suit, before the trial thereof, into the next circuit court of the United States, at the next term thereof, to be held at Boston, within and for the district of Massachusetts, in the first circuit, in accordance with the acts of Congress in that behalf made and provided; and that your petitioner is ready and willing, and hereby offers, to give such good an' sufficient
surety as the law requires for its doing all acts and things re-
73 quired by law to be done upon the removal of a suit into the United States court, and it offers herewith its bond, executed by its authority and in its behalf, and also by William O. Grover and William E. Baker, both of Boston, Mass., as its sureties therein, in the penal sum of two hundred thousand dollars, conditioned that your petitioner shall enter in the next circuit court of the United States, to be held a' Boston, within and for the district of Massachusetts and the first circuit, on the first day of its session, copies of all process, pleadings, depositions, testimony, and other proceedings in this suit, and doing such other appropriate acts as by the said acts of Congress are required to be done upon the removal of a suit into the United States court as good and sufficient surety, according to the said provisions of law, upon the removal of a suit into the United States court.

74 Your petitioner therefore prays, that said bond may be accepted as such good and sufficient surety, according to said provisions of law, and that said suit may be removed into the next circuit court of the United States, to be held at Boston, within and for the district of Massachusetts and the first circuit, pursuant to the statute of the United States in that case made and provided, and that no further proceedings whatever may be had therein in this court.

THE SINGER MANUFACTURING COMPANY,
By INSLEE A. HOPPER,
President.

And further filed its affidavit for removal, as follows:

75 COMMONWEALTH OF MASSACHUSETTS,
Hampshire, ss:

Supreme judicial court.

THE FLORENCE SEWING-MACHINE CO.
vs.
THE GROVER & BAKER SEWING-MACHINE CO.,
The Wheeler & Wilson Manufacturing Co., &
The Singer Manufacturing Co.

Affidavit on behalf of The Singer M'f g. Co., on petition for removal of suit to U. S. court.

I, Inslee A. Hopper, of Newark, New Jersey, president and in behalf of said Singer Manufacturing Company, on oath depose and say that said Singer Manufacturing Company is one of the defendants in the above-entitled suit, now pending in the supreme judicial court for the county of Hampshire and State of Massachusetts, wherein the said defendant has made a petition for the removal of said cause to the
76 next circuit court of the United States, to be held at Boston, within and for the district of Massachusetts, for the reason that said defendant believes that, from prejudice and local influence, it will not be able to obtain justice in said State court. And I further depose and say, in behalf of said defendants, that I have reason to believe, and do believe, that, from prejudice and local influence, the said Singer Manufacturing Company will not be able to obtain justice in said State court, and I make this affidavit in its behalf, for the purpose of removing said suit into the circuit court of the United States for the district of Massachusetts, in the first circuit, in pursuance of the statutes
77 of the United States in that behalf made.

INSLEE A. HOPPER.

Subscribed and sworn to before me this 13th day of April, 1872.
[SEAL.] JAMES MEEHAN
Notary Public in and for the City & County of the State of New York.

And also, on said 16th day of April, filed the following bond:

Know all men by these presents that we, the Singer Manufacturing Company, a corporation created by the laws of the State of New York, and situate therein, as principal, and William O. Grover and William E. Baker, both of Boston, in the State of Massachusetts, as sure-
78 ties, are held and firmly bound unto the Florence Sewing-Machine Company, a corporation created by the laws of and established in the State of Massachusetts, in the sum of two hundred thousand dollars, to the true payment of which sum to the said Florence Sewing-Machine Company, its successors and assigns, we hereby bind ourselves, our successors, heirs, executors, & administrators, sealed with our seals, and executed this fifteenth day of April, A. D. 1872.

Whereas a suit was heretofore brought by the said Florence Sewing-Machine Company against the said Singer Manufacturing Company, and against the Grover & Baker Sewing-Machine Company, a corporation created by the laws of the State of Massachusetts, and The Wheeler and Wilson Manufacturing Company, a corporation created by the
79 laws of the State of Connecticut, which said suit was returnable to the April term of the supreme judicial court for the county of

Hampshire, in said State of Massachusetts, for the year 1871, and was then entered, and is now pending, in said court for trial at Northampton, within and for said county, and is removable unto the circuit court of the United States for the district of Massachusetts, in the first circuit, under the act of Congress approved March 2d, 1867, and the acts to which the said act is in addition and amendatory of.

And whereas the said Singer Manufacturing Company has filed its petition in said supreme judicial court, and also the affidavit required by said act, for the removal of said suit into the next circuit court
80 of the United States to be held at Boston, within and for the district of Massachusetts:

Now, therefore, the condition of the above obligation is such, that if the said Singer Manufacturing Company shall enter or cause to be entered in the circuit court of the United States, to be held at Boston, within and for the district of Massachusetts, on the first day of its stated session next ensuing after the order of the said supreme judicial court for the removal of said suit into said United States circuit court, copies of all process, pleadings, depositions, testimony, and all other proceedings in said suit, and do, or cause to be done, all such other acts & things as by the acts of Congress may be required to be done upon the removal of a suit into the United States court, then the above
81 obligation is to be void; otherwise to remain in full force and effect.

[SEAL.] THE SINGER MANUFACTURING COMPANY,
By INSLEE A. HOPPER, *President.*
W. O. GROVER. [SEAL.]
W'M E. BAKER. [SEAL.]

In presence of—
ELIAS MERWIN.

And these further affidavits are filed by said defendents of the same day.

82 Sup' J. court.

HAMPSHIRE, *ss:*

FLORENCE S.-M. COMPANY
vs.
GROVER & BAKER S.-M. C'Y ALS.

I, W'm E. Baker, of lawful age, on oath depose & say that I reside and always have in Boston, Mass.; that I own in my own right real estate in Massachusetts of the value of at least one hundred thousand dollars, on which there is an incumbrance of less than nineteen thousand dollars, which was on the same when I purchased it, and that I am worth, over and above all debts, at least two hundred thousand dollars.

W'M E. BAKER.

COMMONWEALTH OF MASSACHUSETTS, *Suffolk, ss:*

APRIL 15th, 1872.—Subscribed and sworn to by the said W'm E. Baker, before me.

JAMES J. STORROW,
Justice of the Peace.

83 Sup. J. court.

HAMPSHIRE, *ss:*

FLORENCE S.-M. COMPANY
vs.
GROVER & BAKER S.-M. COMPANY & ALS.

I, William O. Grover, of lawful age, on oath depose and say that I reside in Boston, Mass., and have done for thirty years past; that I own, in my own right, unincumbered, real estate in the State of Massachusetts of at least the value of one hundred thousand dollars; and that I am worth, exclusive of all debts, at least two hundred thousand dollars.

W'M O. GROVER.

COMMONWEALTH OF MASSACHUSETTS, *Suffolk, ss:*

APRIL 15TH, 1872.—Subscribed & sworn to by the said W. O. Grover before me.

JAMES J. STORROW,
Justice of the Peace.

84 And at the term of this court holden at Northampton, within and for said county of Hampshire, on the third Tuesday of April, A. D. 1872, to wit, by adjournment on the twentieth day of May, 1872, after hearing had, it was ordered by the court, to wit, on said 20th day of May, A. D. 1872, that said petitions for removal to the United States circuit court be, and the same are, refused.

And the defendants placed on file the following

Bill of exceptions.

85 Supreme J. court.

HAMPSHIRE, *ss:*

APRIL T., 1872.

FLORENCE SEWING-MACHINE CO'Y
vs.
GROVER & BAKER S.-M. CO'Y ALS.

This is an action brought by the Florence S.-M. Co'y, a corporation of Massachusetts, against the Grover & Baker S. M. C'y, also a Mass. corporation, & the Wheeler & Wilson Manufacturing Company, a corporation created by the laws of the State of Connecticut, and the Singer Manufacturing Company, a corporation created by the laws of the State of New York. Previous to the trial of said case, namely, on the twenty-first day of April, A. D. 1872, the said Wheeler & Wilson Manufacturing Co's and the Singer Manufacturing Co's filed their petition in said case, severally, for the removal of said suit, under the U. S. st's, March 2nd, 1867, ch. 196, to the next circuit court of the United States for the district of Massachusetts, for the reasons set forth in said petitions,
86 and at the same time filed the affidavits of the presidents of said companies in support thereof, and also the bonds of said companies, with sufficient sureties. The said petitioners' affidavits & bonds

are made a part of this bill of exceptions, & copies thereof are to be annexed. The said petitions having been heard & argued before Mr. Justice Ames, it was, on the fourth day of May, A. D. 1872, ordered & adjudged by him that the prayer thereof should not be granted, & that the suit should not be removed, for the reason that the acts of Congress did not apply to this case.

The defendants except to said ruling and order, and pray that their exceptions may be allowed.

May 4th, 1872.

By ELIAS MERWIN, *their Att'y.*

87 And thereupon a jury of jurors was empannelled and sworn to try the issue, who, after hearing all matters and things in the premises, to wit, on the 20th, 21st, 22d, 23d, 24th, 27th, 28th, 29th, and 30th days of said month, returned into court, to wit, on the 30th day of said month, the following verdict:

Supreme judicial court. April term, A. D. 1872.

COMMONWEALTH OF MASSACHUSETTS,
Hampshire, ss:

THE FLORENCE SEWING-M'CH CO., PL'FF,
vs.
THE GROVER & BAKER SEWING-MACHINE CO., The Wheeler & Wilson Manufacturing Co., and The Singer Manufacturing Co., defendants.

88 The jury find for the plaintiff, and assess damages in the sum of thirty thousand three hundred and forty-eight dollars and twenty-eight cents.

THOMAS NASH,
Foreman of the first Jury.

Which verdict was duly affirmed and entered of record.

And during said trial, to wit, on the 22nd day of said May, the plaintiff filed the following

Disclaimer.

Supreme judicial court for the county of Hampshire, at the adjourned term, May 20, 1872. Action of contracts.

THE FLORENCE SEWING-MACHINE COMPANY
vs.
THE GROVER & BAKER SEWING-MACHINE Company & others.

Whereas since the commencement of the above-entitled action the defendants therein have become entitled to certain license-fees
89 under the license and contract therein set forth, at the times and to the amounts following, namely:

On the tenth day of January, A. D. 1871, the sum of..... $1,561 60
On the tenth day of April, A. D. 1871, the sum of..... 961 20

On the tenth day of July, A. D. 1871, the sum of 1,757 60
On the tenth day of October, A. D. 1871, the sum of..... 1,935 60
On the tenth day of January, A. D. 1872, the sum of..... 1,724 40
& on the tenth day of April, A. D. 1872, the sum of..... 1,438 00

And are entitled to retain out of the moneys previously overpaid by the plaintiffs and had and received to the plaintiff's use, the said sums, amounting in the whole to $9,378.40, and the plaintiff has therefore no longer the right to recover said sum of $9,378.40, parcel of the money so overpaid, and had and received, to recover which the suit is brought. The plaintiff now wholly disclaims all right to recover the sums aforesaid, amounting as aforesaid, to $9,378.40.

FLORENCE SEWING-MACHINE CO.,
By A. L. SOULE.

90 And on the last day of said term, to wit, on the 30th day of said month, this action was continued nesi. And at the term of this court, holden at Northampton, within the county of Hampshire, and for the counties of Franklin and Hampshire, on the Monday next after the second Tuesday of September, A. D. 1872, to wit, on the seventeenth day of September, A. D. 1872, the following bill of exceptions was, by agreement of parties, filed as of May 30th, 1872, and allowed and signed by the Hon. Seth Ames, the presiding justice at the trial aforesaid.

91 Supreme judicial court. April term, 1872.

HAMPSHIRE, *ss:*

FLORENCE SEWING-MACHINE COMPANY
vs.
GROVER & BAKER SEWING-MACHINE COMPANY et als.

Exceptions.

This was an action of contract. The pleadings are made a part of the case. The plaintiff is a Massachusetts corporation. The defendants are The Grover & Baker Sewing-Machine Company, a Massachusetts corporation, The Wheeler & Wilson Manufacturing Company, a Connecticut corporation, and The Singer Manufacturing Company, a New York corporation. Before the trial of the case The Wheeler & Wilson Manufacturing Company and The Singer Manufacturing Company filed several petitions for the removal of said case to the circuit court of the United States, under the United States statutes of March 2, 1867, chapter 196, together with affidavits and other papers filed therewith, and a hearing was had on said petitions. The court refused to grant the petitions, and ordered the case to proceed to trial, reserving the question for the consideration of the whole court.

The suit was brought to recover back the amount of certain license-fees which the plaintiffs had paid, as they contended, to the defendants in ignorance or under a mistake of facts, and which had been wrongfully taken by the defendants.

At the trial it was proved or admitted that the plaintiffs were a manufacturing company, making a sewing-machine known as the Florence sewing-machine, and which was a drop-feed shuttle sewing-machine using two threads; that the defendants were respectively manufacturers

and owners of the Grover & Baker, the Wheeler & Wilson, and the Singer sewing-machines; and also owned, either jointly or severally, the legal title of several patents for improvements in sewing-machines, several of which were used by the plaintiffs in their machine; that on February 20, 1868, the defendants gave the plaintiff a license to use their inventions, a copy of which, marked A, is annexed.

92 The 7th clause of the license is as follows:

"Seventh. No other license for a drop-feed shuttle sewing-machine, using two threads, is to be granted by said licensers under the before-mentioned patents at a less patent rent per machine, without a corresponding reduction in the patent rent herein reserved; and machines of the same pattern are not to be licensed to different parties."

On Oct. 1, 1868, the defendants made an agreement with The Davis Sewing-Machine Company, a copy of which is annexed, marked B, by which they licensed said company to use on the Davis machine certain improvements, and to make of such machines not exceeding 50,000 in number, for the sum of $20,000. The Davis machine was a shuttle-machine, using two threads. The plaintiffs contended that the Davis machine thus licensed was a "drop-feed shuttle sewing-machine, using two threads," within the meaning of their license, and that the effect of this license to the Davis company was to reduce their own license-fee from and after said Oct. 1, 1868, to forty cents per machine. After said Oct. 1, 1868, the plaintiffs continued to pay to Mr. Gifford, the receiver of the defendants, named in their license, the full license-fee of $5 for domestic and $2 for exported machines, in ignorance, as they claimed, of the terms of the Davis license until and including October, 1869, being the sum of $ for machines. And upon the evidence in the case it was not contended by the defendants that the plaintiffs were informed of the terms of the Davis license until Nov. 1, 1869. At the trial it was a controverted question between the parties whether the Davis machine was a "drop-feed machine" within the meaning of said license, and testimony bearing upon that issue was introduced by both parties. But it was not controverted that the Davis machine embodied some of the inventions, other than the drop-feed described in the patents included in the defendants' license.

The defendants offered testimony to show what description of sewing-machines were known and designated in the sewing-machine trade and business as a "drop-feed" machine subsequently to February, 1868, and down to and including October, 1868, and that the Davis machine did not come within that description; but the court excluded this testimony, but allowed the defendants to introduce testimony as to what was known and designated in the trade as a "drop-feed" preceding and about February, 1868. The plaintiffs introduced testimony tending to prove that the Davis machine was not known in the trade in February, 1868.

The defendants called a large number of persons who had been engaged in the manufacture, sale, and use of drop-feed sewing machines for a long time prior to February, 1868, and also subsequently thereto, and put to them this question: "When, if ever, for the first time, did you hear or know of the term drop-feed being applied to the Davis machine?" but the question was excluded.

93 The defendants offered to prove by the original licenses that when the Davis license was granted there were then in existence a large number of licenses from the defendants to other parties, similar in terms to that of the plaintiffs', and each containing a clause similar to said 7th clause, and each of which they claimed would be affected in the same manner as the plaintiffs' license by any other license of a drop-feed machine at a less rate, but the testimony was excluded.

The defendants called George Gifford and S. J. Gordon, esqs., who testified that at the time the licenses in question were granted, and for several years previously, they had been the counsel of defendants, having it for their especial duty to attend to the preparation and granting of licenses by the defendants; that they were and for many years had been familiar with the different varieties of feeding-mechanism used in sewing-machines, and with the names by which they were known and identified in the sewing-machine trade and business. The defendants offered to prove by them that, before the license to the Davis company was granted, their opinion was asked by the defendants as to whether the granting of such a license for the Davis machine would have any and what effect upon the plaintiffs' license. They also offered to show that these witnesses, after making an examination of the Davis machine, expressed their opinion to the defendants as to the character of the feed in the Davis machine, and as to the effect of its proposed license upon the plaintiffs' license, and what that opinion was. They also offered to show that after examining the Davis machine, and before the Davis license was given, the said witnesses made a communication to the defendants, and what that communication was; but these several offers of proof were all excluded.

But the said Gifford & Gordon were allowed to and did testify that, in their opinion, the Davis machine was not what was understood in the trade in 1868 as a drop-feed machine, and that they had always been of that opinion.

The defendants, among other things, contended and introduced testimony tending, as they claimed, to prove that in February, 1868, the term "drop-feed" was applied exclusively to a certain form of feeding-mechanism in which the feeding-bar rose up from underneath the table against the lower surface of the material, and after moving or feeding it the required distance, receded from the material, as distinguished from the feeding-mechanism which was applied from the top of the table to the upper surface of the material, and that these latter were known as a distinct class of feeds by the name of top-feeds, and that the Davis machine belonged to the class of top-feed machines, and as bearing upon this question they offered letters-patent of Great Britain granted to George B. Woodruff, A. D. 1866, for a certain improvement in the feeding-mechanism of "top-feeding sewing-machines;" but the testimony was excluded. No evidence was offered that the invention in that patent, or its designation, was known in the trade in this country in 1868.

94 It appeared in evidence that the said license to the Davis Manufacturing Company was cancelled, by the consent of the parties thereto, Dec. 1, 1869, in consideration of an agreement, a copy of which was put in evidence and may be referred to.

The defendants contended and requested the court to rule that the license to the Davis Manufacturing Company of October 1, 1868, did not grant or cover any license to use any of the inventions or patents specified in the plaintiffs' license, but only granted a license to use the inventions described in the patent to W'm H. Johnson, therein named, and consequently that the granting of the Davis license could have no legal effect to reduce the license-fee reserved in the plaintiffs' license.

They also contended, and requested the court to rule, that if this were not so, that the cancellation of the Davis license as aforesaid put an end to any claim of the plaintiff to a reduction in their patent rent thereafter, and they offered to show that when said Davis license was cancelled not more than 3,500 Davis machines had been made, and they

contended and requested the court to rule that the plaintiffs were consequently entitled to no reduction whatever in their license-fee, or, if to any reduction, for not more than 3,500 machines, and that in no event were the plaintiffs entitled to any reduction beyond 50,000 machines; but the court declined so to rule, and rejected said testimony, and ruled that if, in the opinion of the jury, the Davis machine was a drop-feed machine, the plaintiffs were entitled to have their license-fee reduced from five dollars to forty cents per machine for all the machines they might manufacture after the date of the Davis license and during the existence of their license.

It appeared that the plaintiff had manufactured, since Oct. 1, 1868, and up to May, 1872, over 50,000 machines.

It appeared in evidence that the money which the plaintiffs seek to receive back in this action had been paid by them to George Gifford, esq., the receiver named in their license, and had by him been paid over, immediately after its receipt and before the commencement of this action, to the three defendant companies respectively, one-third to each; and the defendants offered to show that, by virtue of the agreement existing between themselves when the plaintiffs' license was made, all license-fees paid thereunder to the receiver were to be divided among and paid over to them in the proportion of one-third to each; and they contended and requested the court to rule that the plaintiffs could not maintain a joint action against all the defendants for the money so paid, but only a several action, if any, against each for the amount it had received.

That if entitled to recover at all, the plaintiffs could not recover any interest on said payment until after demand; but the court excluded said testimony and declined so to rule, and ruled that if the Davis machine was a drop-feed machine the plaintiffs would be entitled to recover of the defendants in this action the full amount of the
95 several payments made by them to said Gifford as license-fees, over and above the forty cents per machine, with interest thereon from the date of each payment without any demand.

The letters-patent to W'm H. Johnson, to A. B. Wilson, and to W. P. N. Fitzgerald, specified in said licenses, were put in evidence, and may be referred to.

The plaintiffs contended, and introduced testimony to prove, that the terms "drop-feed" and "four-motion feed," as known by the trade in 1868, were synonymous, and that the term "four-motion feed" meant the feeding-device shown in the said patent of Fitzgerald, and that the Davis machine embodied substantially that feeding-device. They also introduced testimony to the effect that the defendants, before the licence to the Davis company was granted, had instituted two suits in equity, in the U. S. circuit court, against said Davis Company: in one alleging that said Davis machine infringed the patent of said Johnson for a needle-feed, and in the other that said machine infringed the patent of said Wilson for the feed-motion, or scratch-feed, and that a hearing for a preliminary injunction was had in said last-named case, and a preliminary injunction was obtained therein. A copy of the record in said case, and of the opinion of the court granting said injunction, may be referred to.

The defendants contended, and introduced testimony to prove, that the term drop-feed was applied exclusively to that form of the four-motion feed which is applied underneath the table, as shown in the Wheeler & Wilson machine, and, also, that the said Davis machine was neither a drop-feed nor a four-motion feed machine in any sense in which those terms had ever been understood or applied; but that said Davis ma-

chine was substantially a needle-feed machine, or, if not a needle-feed machine, that it was a new form of feed-mechanism, combining the main features of said needle-feed mechanism, and only incidentally, if at all, some of the features of the drop-feed as described in said Fitzgerald patent, and that the practical feeding was done by the needle and while it was thrust through the material to be fed.

It was proved, and admitted by the plaintiff, that said Davis machine, in its feeding-mechanism, infringed the said patent of William H. Johnson.

The defendants requested the court to instruct the jury as follows:

1. That the plaintiffs cannot recover unless the jury are satisfied upon the evidence that the Davis machine is a "drop-feed" shuttle sewing-machine.

2. That, if the term "drop-feed" had acquired a fixed and definite meaning in the sewing-machine trade and business at the time the Florence license was granted, the law conclusively presumes that that
96 term was used in their license in that sense; and unless the feeding-mechanism in the Davis machine is such as was known and understood in the trade as a drop-feed, the plaintiff cannot recover.

3. That an order that one machine shall be substantially the same as another, the one must either employ identically the same mechanical devices as the other, and in substantially the same combination; or, if it employs different devices, the substituted devices must be well-known equivalents for the other, and such as would be suggested to a mechanic having ordinary skill in that art, without the exercise of any invention. But if one machine is not in the same form, or does not employ the same devices in the same combination and arrangement as the other, and if the new arrangement required invention to make it, then the one machine is not, in contemplation of law, substantially the same as the other, but is substantially different.

4. That one machine is not substantially the same as another if the arrangement of parts in one is actually different from that in another, and it requires invention to make the new arrangement.

5. That one mechanism is not substantially the same as another merely for the reason that it employs one or more parts contained in a prior machine, nor because it thereby infringes upon such prior machine, and that the true question in the case is not whether the Davis machine infringes the Fitzgerald patent, but whether the Davis machine is substantially such a feeding-mechanism as was known in February, 1868, as a drop-feed; that although it appears that the Davis machine did infringe the Wilson two-motion feed patent, it does not follow that it is an infringement of the Fitzgerald patent, or that it is a drop-feed mechanism.

6. That, if the feeding-mechanism in the Davis machine is applied and operates upon the top of the machine, and if, in all prior drop-feed machines, the feeding-mechanism was applied and operated from beneath the table of the sewing-machine, and if it required invention to make this change in what had been previously employed in drop-feed machines, the Davis machine is not substantially a drop-feed machine within the meaning of the Florence license.

7. That if, in all drop-feed machines as they existed prior to the Davis license, it was essential that the needle should be out of the material when it was fed, and if it is essential to the operation of feeding in the Davis machine that the needle shall be in the material when it is fed, and if it required invention to make this change, then the Davis machine is not substantially a drop-feed machine.

97 8. That the feeding-mechanism in the Davis machine is not

substantially the same as that in the drop-feed machines, merely because each of them contains a part which is covered by some preceding patent.

9. That although the feeding-mechanism in the Davis machine is composed of material portions of the needle-feed, combined with one or more parts of what was previously known as the drop-feed, such new combination constitutes a feeding-mechanism which is not a drop-feed, and is substantially different from it.

10. That the fact that the helper does all the feeding in the Davis machine does not make that a drop-feed machine, if the combination and arrangement by which this effect is given to the helper in the Davis machine is different from that found in all prior drop-feed machines, and such new combination and arrangement required invention.

11. The patent of W'm H. Johnson, of February 26, 1856, so far as it relates to the feeding-mechanism therein described, is exclusively for "the feeding of the material to be sewn by means of a vibrating piercing instrument, whether said instrument be the needle itself, or any independent instrument in the immediate vicinity thereof," and consequently no other feeding-device can infringe that patent unless such feeding-device feeds the material by the needle or some other piercing instrument while the needle or such other piercing instrument is through the material and moves with it; that the Davis machine, in order to infringe the Johnson patent, must embody substantially that needle-feed device, and that if the Davis machine does thus infringe the Johnson patent, it is substantially a needle-feed mechanism, although it may embody one or more elements of the drop-feed mechanism; and that if the jury believe the testimony of the plaintiffs, they are bound to find that the Davis machine does infringe the Johnson patent, and consequently is substantially a needle-feed mechanism.

12. That by the true construction of the contract in suit, the defendants did not agree with the plaintiffs not to license any person under the Fitzgerald four-motion feed patent, without a corresponding decrease of the plaintiffs' license-fee.

13. That there is no testimony in the case which will warrant the jury in finding that the Davis machine is a drop-feed machine, or is substantially a drop-feed machine, as that term was understood and employed when the Florence license was granted.

98 The court declined to give these instructions, and instructed the jury as follows:

GENTLEMEN OF THE JURY:

You will please to remember, gentlemen, that the first thing that you are to do on going to your room will be be to elect a foreman by ballot. It will be time enough to report his name to the court when you come in with your verdict.

In the course, gentlemen, of this long and laborious trial, a great mass of testimony has been introduced and submitted to your consideration, and the case has been very laboriously and faithfully considered.

It is a case of great magnitude and importance, and your verdict, whichever way it may be, will make a great difference to some very large and important interests. The case, besides, is of a kind which is not usually investigated in the local courts of the State. It is generally tried in the United States courts. It has been tried with great zeal and vigor, and, it is fair also to say, with great thoroughness and ability by the counsel. But I think, after all, it will be found that the real ques-

tion in dispute is perfectly distinct and easily stated and appreciated; and it will also be found that the general rules of law that govern the case are simple, and intelligible, and reasonable. I cannot promise you, gentlemen, that you will have no difficulty in the investigation, but whatever difficulty you do meet with will not arise from any intrinsic difficulty in deciding the question in dispute. So far as the facts are controverted you may find more or less difficulty in coming to a conclusion; but I think you will not fail to understand what the questions are and what the general rules of law that govern it are.

And, first, gentlemen, I think you must consider what was the position of these parties in relation to each other before any controversy arose among them. The plaintiffs were manufacturers of sewing-machines, and the defendants were the owners of a large number of patents, without which the prosecution of that business could not be carried on with success. Some arrangement had been existing between these parties previously.

In February, of the year 1868, they made a new arrangement, the result and effect of which were that these plaintiffs were to have the privilege of using certain patents, as exemplified by the specimen machine. And for that privilege they were to pay a certain agreed price, namely, the sum of five dollars for each machine. Under the seventh article of the contract a provision was made, the apparent object of which was to secure to them the privilege or some security against unfair competition; that is to say, the effect of this seventh clause would be that no reduction could be made in the price of such a license, or any license to use these patents, without making a corresponding reduction to these plaintiffs, an apparent object of which is that the plaintiffs might be sure that nobody would be in possession of the same patent-rights with the privilege of using them on any better terms than themselves.

99 It is not very important in this connection to consider what the inducements were that made the parties enter into this particular contract. It is enough that they saw fit to make such a contract, and it ought to be presumed that they found it for their mutual interest to make such a contract in that form. And the contract defines their rights and furnishes the measure of their respective claims against each other. It is of no consequence to consider what relations these defendants stand to other parties who had licenses. That does not affect the relations between the two parties to the suit. There is no evidence before you, as I know of, what precisely these relations were. And the rights of the parties, the immediate parties to the suit, depend on the contract they have made—the language they have made use of in that contract for the purpose of expressing their own views and their own claims.

On the first day of October following, the defendants made an arrangement with the Davis company, and the effect of the arrangement was that the Davis company was authorized and permitted after that time to make and put upon the market the machines of which specimens have been exhibited here before you, at a lower rate, that is, at the rate of forty cents per machine. The machine which they did make under that authority you have heard described in various forms, and you have seen samples of these exhibited here. And the claim that these plaintiffs make is, that under this seventh article of their contract they are now entitled to have their patent-rent rates reduced to forty cents each machine. They claim that that is the rate at which the Davis company make a similar machine, and that by the terms of

the contract they are entitled to be charged no higher rate. In other words, they say that the Davis machine is a drop-feed sewing-machine, using two threads, and that under the seventh article of the contract they ought to have been charged that first day of October, 1868, forty cents only; and that all money that they have paid over and above forty cents after the first day of October, 1868, as it was reckoned at five dollars a machine, instead of forty cents a machine, all excess over forty cents that they have paid, has been wrongfully taken out of them, and that they have a right to recover it back; at least all that they have paid at any time previous to the first day of October, 1869. That is their claim.

Then, gentlemen, the great practical question in the case would be, was the Davis machine a drop-feed machine. If the plaintiffs have proved that it was, taking that term according to its true acceptation and meaning in February, 1868, as understood by the trade, then the plaintiffs are right in saying that they have overpaid, and that their patent-rent ought to have been reduced from five dollars to forty cents after that date, and that all that they ever paid above forty cents was wrongfully taken, and that they have a right to recover it in this suit, with the single exception of what they paid in November, 1869. That is their claim, in general terms.

100 Now, gentlemen, it is not to be forgot that on this point the burden of proof is on the plaintiffs. They come here making a claim; they present to you an affirmative proposition upon the proof of which their rights depend. If they do not succeed in proving it, but leave it doubtful, they fail in making out their case, and the defendants shoud be entitled to a verdict.

Then, gentlemen, what was the construction, the proper construction, of the contract which they made? The plaintiffs were manufacturers, and desired to have the benefit of certain patents. That is what they were bargaining for, and that is what the defendants gave them, with the limitation that they were to use the patents in the form in which they were exemplified in that specimen machine. And there is a further stipulation that no other license shall be granted for a drop-feed sewing-machine using two threads. There is no doubt that this Davis machine uses two threads, and is a shuttle sewing-machine. And the question is, is it a drop-feed, and what is the meaning of that clause in the contract? It appears to me, gentlemen, that the true construction is, that no license for a drop-feed machine means no license for any drop-feed machine whatever, using that term according to its meaning at the time of the contract, and that the plaintiffs' right is not confined to any particular form of machine in use; but that it extends to any and all kinds of feed which come under the proper meaning of that term as it was understood in the trade at the date of the contract, and that the defendants' promise is not to be restricted to any particular mechanism in which that kind of feed had been previously applied, and that it extends to every form of machine in which the feeding invention covered by these patents and constituting that kind of feed should be thereafter applied. It is true, gentlemen, and it is admitted, that the only form in which that kind of feed was applied up to that time in this country was the only form in which it was known to the trade here in this part of the world, was a device in which two parallel surfaces were used, between which the cloth was clamped or held, and in which the surface under the cloth was roughened, or furnished with notches or points in order to press against it and move it forward at every stitch. That was

the only form in which that kind of feed had been used in sewing-machines up to that date in this country.

Then, gentlemen, if at the time of contract, that is, in February, 1868, there was a well-settled and understood usage in the trade that the term drop-feed meant that particular form or application of the four-motion feed which I have just described as distinguished from the form in which it is contained in the Davis machine, then it would follow that the Davis machine is not to be considered as a drop-feed machine.

But the plaintiffs wholly deny that there was any such usage or understanding. They insist and they claim that the term "drop-feed" and the term "four-motion feed" were interchangeable terms, meaning exactly the same thing; that the term defines the principle or the specific kind of force or device by which the cloth is forced along at
101 each stitch by these four motions, which have been so many times described to you, by the influence of frictional pressure, and that all that is covered and included in these patents that have been submitted to you. They claim that what they bargained for was the benefit of these patents without regard to the particular form in which they might be applied and used by other persons, who should get a license to use them after that time.

Well, gentlemen, what is the meaning of the term drop-feed? It is not a term that you will probably find in any dictionary. It is a term of the trade. It was a term which it was said on the part of the plaintiffs was invented for the convenient description of a particular kind of forcing of the cloth along at each stitch. It is a term that was not used in any of the patents whatever; and, as the plaintiffs claim, it was merely a convenient and abbreviated way of describing a particular mode or fashion in which the cloth is fed or moved along in the machine to receive the stitches one after the other. They claim, also—but as I understand, it is not a matter of serious controversy—that the term drop-feed, as used in that connection, is not to be used in its most literal sense; that any machinery, or spring, or device which has the effect of forcing down one of these surfaces is exactly the same thing in effect, for the purposes of this trial, as if the same surface or thing dropped down merely by its own weight. I understand many of the witnesses on the part of the defendants to describe it in exactly that manner.

Well, gentlemen, if you look at the Davis machine—as you did very carefully, I have no doubt—you find that the device for the application of the feed, the application for the feeding, is above the cloth, and that the needle is in the cloth at the moment that it is fed along to receive the next stitch. In that respect it differs from all the machines that were in use in February, 1868. And the question of course is, what the term meant at the time it was made. The plaintiffs claim that these differences are unimportant and trivial; that they do not affect the identity of the feed; that the effect in the two machines is substantially the same thing as the term drop-feed was understood in February, 1868; that it operates in precisely the same way; that is, that it operates by four motions combined with frictional pressure. That is the claim which the plaintiffs make.

Well, gentlemen, on the question of the identity of two inventions with each other, or their similarity to each other, the material point of inquiry generally is, not whether there are precisely the same elements of motion, or the same component parts, but whether a given effect is produced substantially by the same means of operation and by the same combination of powers. If they perform the same service, or produce

the same effect in the same or substantially the same way, they are the same thing in principle. Well, the principle of a machine may not be very easily defined in words. It is a practical question for the jury to pass upon; and the rule as given by the law, is stated, I believe, in the terms which I have now made use of. If the two are the same in
102 principle, mere slight difference in form or external mechanism are of no importance whatever. You may find on examination of two machines that the top in one is where in the other you find the foot, and that the foot in one is where in the other you find the head. But if that kind of difference is the only kind, it would be unimportant for the purposes of this trial. The question still would be, is the principle the same thing? Another mode of stating it is, gentlemen, that the same general plans, applied for the same purpose, would make them the same in principle, although the mode of construction might be different, and although one might work more successfully than the other, or be executed with more mechanical skill. Any variance or any circumstance not material to the substance or the principle of the invention, as it was understood in 1868, would be of no account. The critical point in the inquiry is not whether the new machine is better than the old one, and, in this case, not whether the new feed works better than the old one; it may be a decided improvement; but whether, with all its improvements, it belongs to essentially the same general description, or is one of the same kind. It is not strictly a question here of infringement, but it is a question whether the same kind of feed, defining it as I have tried to define it, is used in both of these machines. There might be, gentlemen, apparent mechanical differences between the two, and yet both might be included under one descriptive term. For instance, a new machine might use an invention included in some previous patent; it might be so contrived, as besides doing that, to furnish some decided advantage, some benefit; but it would still be an infringement of the old invention, because it would include the old invention, and the fact that it added something more to it would not deprive it of its character of being an infringement and encroachment of the previous patent. To take an illustration that is sometimes given, gentlemen: When watches were first invented, it is easily to be supposed that the first watch that was made may have indicated the hours only; may have had no minute-hand and no second-hand. In course of time it would come to be manufactured by the addition of a minute-hand, and although it would be very greatly improved by the addition of the minute-hand, and made practical and very much more valuable, still, the man that added the minute-hand would have no more right to use the previous invention without the leave of the previous patentee than he would if it was an entire encroachment throughout. Each of the inventors must make use of his own invention, and each would depend upon the other for the right of using interchangeably the whole.

Thus, gentlemen, there might be an alteration in the mode of feeding which would still be an infringement upon the previous mode, although it included some additional device besides the original invention. The inquiry which you are to make is as to the identity of the two, not in form, but in substance and effect.

Then, gentlemen, what are the elements and characteristics of
103 drop-feed as the term was understood in February, 1868? The plaintiffs say that these elements are, and those characteristics are, the four motions, combined with the frictional pressure. They insist that this enumeration includes the whole; that in those five elements, if I may call them five, or in those two, as I might more correctly say, perhaps,

resides and is to be found all that is meant by the term drop-feed, and all that was meant at that time, and that all these are to be found in the Davis machine, and that these constitute the merit and the usefulness of the Davis machine, and that the Davis machine has, in point of fact, stolen a leaf out of their book and appropriated what belonged to them.

But to this, gentlemen, I understand the defendants to make two answers. They say, in the first place, that these two elements, the motions and the frictional pressure, did not make up the whole of what is meant by drop-feed, as understood in the year 1868; that that term was used to describe a mode of feeding different from what was understood as top-feed; among other things, that it describes a mode of feeding in which the pressure is applied on the top of the cloth instead of under it, and in which the needle is not used as an element in the process of feeding.

Well, the plaintiffs reply that the term top-feed was not known to the trade in this country at that time, not generally known; that it was a term that may have been known in foreign countries, but that it was not known here, or at least not known so generally that you can assume that it was known to the parties who entered into the contract; and furthermore, even if it was known in point of fact, it was still, after all, nothing more than another mode of applying the same kind of feed, and was a drop-feed, a four-motion feed, after all, by whatever term it might be called.

Another answer, gentlemen, which the defendants make, and upon which they have expended a good deal of time and labor, and which you must consider, is, that the Davis machine does not, in point of fact, make use of frictional pressure; that it has four motions, to be sure, but that so has the needle-feed in all cases—the needle-feed proper; it descends, it moves forward, it rises, it returns; and they insist that this Davis machine does not make use of frictional pressure at all; or if it does so at all, it is only incidentally, and not for the purpose or with the effect of furnishing a feed to the machine.

Well, gentlemen, upon the matter in dispute, a great many experts have been upon the stand on both sides, and they have conflicted very much with each other. On the side of the plaintiffs, it is said that drop-feed and four-motion feed are terms which meant exactly the same thing; that, after all, although the Davis machine pretends to be a needle-feed machine, as they say, you will find, on close examination, that the mode of feed is really the pressure of the cloth between two surfaces,
and moving it forward by means of the four motions; that the two
104 machines in that respect are alike, although there is some attempt to make an apparent difference in the Davis machine; and that the Davis machine is in substance and effect a drop-feed machine, and nothing more.

But, gentlemen, on the other hand, the experts who are called by the defendants, with precisely as much confidence and positiveness, say that the Davis machine is practically a needle-feed, and not a drop-feed machine. Some of them say that it is a new and original combination of feeds of two kinds, but that it does not embrace really, in substance and in fact, what has been defined as drop-feed. And the conflict, gentlemen, between these experts, does not stop merely at the general description of the kind of machines, and at giving them a name, by calling one a drop-feed and saying that the other is not a drop-feed; but it goes through many details. On the plaintiffs' side, it is said that the needle is substantially inefficient as a feed, incapable of any useful

action without the helper; that the feed is really and in substance a pressure of two opposite surfaces, and the helper is so contrived as to take hold of the cloth and press it down and force it forward, not with so large a surface as in the Florence machine, not, perhaps, with so great a pressure, but still effectually and substantially doing that same thing. On the other hand, the claim is, that the helper does nothing but smooth the cloth and prevent it from rising when the needle rises, and that it either has no feeding quality at all, or that it has so little as to be of no practical importance, and that in substance and effect there is really no pressure of two opposite substances against each other.

Well, gentlemen, thus stands the testimony of the experts. I do not intend to go over it in details. It would be a matter of very great difficulty to do so, and it does not properly belong to the court to do it. All I can say is, you must remember it as well as you can, and apply it as well as you can.

There are some matters beside on which the plaintiff rely. And here I mention the injunction which was obtained against the Davis company, on the application of the defendants. When the Davis machine appeared in the market, they complained of it as a violation of their patent, or some one of their patents. That was the ground upon which they attached it, and upon which they sued and relied in New York, and upon which they obtained an injunction to suppress it and prevent its use. They admit, of course, that they claimed and that they exercised the right to stop the Davis machine, on the ground that it conflicted with theirs. And what the plaintiffs say is, that in that complaint their objection was that the Davis machine had in fact stolen their mode of feeding the cloth.

To this, gentlemen, the defendants answer, that it is true that they did complain that their patent had been infringed and invaded; but what they say, is, that they did not make a general objection to the feed of the Davis machine. They say what they did object to was not the copying of their feed combination, but some specialty, or some
105 distinction, or some specification as to the application of the drop-feed, which might be the subject of separate patent.

Mr. ABBOTT. If your honor please, we never made any claim, the slightest in the world, or hinted at it, that it was an infringement, or interfered with the drop-feed at all. We never alluded to it in any way.

The COURT. I believe I was about to put that. They say, then, gentlemen, that they did not complain of it as an infringement of the drop-feed. The record in the case (and that will be before you) shows that the complaint was that it violated two of the defendants' patents, and, as I understand, two of A. B. Wilson patents.

Mr. ABBOTT. No, your honor, the Johnson needle-feed and the two-motion. There was a suit at the same time, and this suit was on the A. B. Wilson patent. It was the same, re-issued; the same patent, the original and the re-issue.

The COURT. Well, the record in the case, as I understand it, shows that the complaint was, or at least Judge Nelson's opinion seems to indicate, that it was a violation of the scratch-feed, a renewal of some of the scratch-feed patents.

Mr. ABBOTT. The two-motion scratch-feed patent.

The COURT. And that the patent which is called the scratch-feed had something to do, of course, with the feed. But the defendants' reply to this complaint, or this charge, that what they complained of then was, not that the Davis machine was a drop-feed machine, that they did not attack it on that ground at all, but that they attacked it on the ground

that it was a needle-feed machine which had borrowed a part, or some portion, of what is included in some one of their patents. I believe I am right there.

Mr. ABBOTT. Yes, your honor; in a specific patent, the two-motion rather than the four-motion.

The COURT. Well, gentlemen, an admission of that kind, giving it its utmost force that it can have, is merely as evidence. It is not conclusive or binding upon the parties. It is evidence which you are to consider with the rest; but still the question is open, and is to be decided by you, whether the feed, as used in the Davis machine, is, after all, a drop-feed. That is a point upon which mere admissions, made by the parties at any previous period, will not finally and absolutely conclude.

So, gentlemen, with regard to the contract afterwards made. You heard the use that was made of that in the argument, and you will consider what weight and effect is to be given to it, if you think it is to be entitled to any. I do not propose to go into that part of the case at all.

And then, gentlemen, you have all this great mass of conflicting evidence, and the force and effect of it all is for you to consider. I can give you no advice on such a matter as that, a question of fact,
106 which is peculiarly in your province, excepting to say that the responsibility belongs to you, and that it is a serious responsibility, and that you must consider the evidence with very great carefulness and let it produce upon your minds the effect which naturally belongs to it, and no more.

I told you that the burden of proof was upon the plaintiff. And I think that I ought to illustrate a little more fully what I mean by that term, although I believe it is tolerably familiar. It is a term very often used in the courts, and it contains a very salutary and wholesome rule of law on which the administration of justice in a great measure depends, and it is one that it is important that you should fully understand.

The plaintiff is making a claim which the law requires him to prove in order to get your verdict. He must satisfy you reasonably, by a fair preponderance of the evidence, that the Davis machine was at that time a drop-feed machine. It is not enough for him to create a doubt on the subject. If the result of all their evidence is to leave you in a state of uncertainty whether the Davis machine was a drop-feed machine or not, why, all that can be said is, that the plaintiff has not done what the law requires him to do in order to make out his case. He must prove to your reasonable satisfaction, by preponderance of evidence, that the Davis machine was a machine of that description.

Well, preponderance of evidence, gentlemen, means that the evidence which the plaintiff offers must weigh more in your minds, in order to convince you, than the evidence which comes from the other side. If the evidence stood exactly even in the balance so that you could not say that one weighed more, or amounted to more, than the other, the result would be a failure on the part of the plaintiff. But preponderance means a greater weight of evidence. And that is to be determined, not by counting the witnesses on the two sides, for that would cause a case on trial to degenerate into a mere problem in arithmetic; it is still a question, Has the plaintiff convinced you reasonably, by a preponderance of proof, that the Davis machine at that time was a drop-feed machine? If he has, why, then he is entitled to your verdict.

And in deciding that question, gentlemen, you are to look simply at

the rights of the parties as expressed in their contract, and as given to you in evidence. You are not to consider the magnitude of the interests involved, or the difference that it may make to one set of people or another. You are not called to go into any inquiry as to liberality or kindness, etc. The parties are here upon their legal rights, and nothing else; and you are to pass upon them simply as you would do a legal sum. These are all corporations. The fact that some of the corporations are from a distant State, of course will make no difference to you.

Then, gentlemen, if you come to the conclusion that the plaintiffs have made out their case, as I understand it, the amount which they are entitled to recover is a mere matter of computation, about which there is no serious difficulty. If the plaintiffs are entitled
107 to recover anything at all, it is what they paid for three of the quarters after October, 1868; that is, what they paid for the quarters ending January, April, and July, 1869. I don't know but it would be convenient for one of you, gentlemen, to take a pencil and take down the figures which I shall give to you.

Well, gentlemen, the number of machines for which they paid five dollars in January, 1869, was 3,331, reckoned at five dollars each. I will only give you the materials for making the computation. The same machines, as they claim, (and, if they have made out their case, which they are entitled to claim,) should be reckoned at forty cents apiece only. These 3,331 machines, if the plaintiffs are right, should be reckoned at forty cents a machine; and, in my view of the case, gentlemen, they are entitled also to collect interest on the sum, the sum so overpaid, from the 10th day of January, 1869, which was the date when they made the payment.

JURYMAN. Was not a paper laid on the table that the jury was to have, or was that ruled out?

The COURT. I find the parties do not agree to receive it. I believe there is no dispute as to the number of machines, and the rest is mere matter of computation. Three thousand three hundred and thirty-one machines have been reckoned at five dollars each, which should be, as the plaintiffs claim, at forty cents, and bear interest from January 10th, 1869.

Then you come to the next quarter, two thousand six hundred and seventy machines; two thousand six hundred and seventy machines have been reckoned at five dollars each; should be at forty cents each; interest from the 10th of April, 1869, which is the date of payment.

Mr. HOAR. I think we can save all this, your honor. If your honor should tell the jury that if they find for the plaintiff they should find the bottom sum of our computation, it will be clearly within what the other side say we should recover, if we recover anything; and we are content.

Mr. ABBOTT. I am content that your honor, having made a computation, should state it to the jury, and give it in the gross sum. Of course we do not agree to anything; but where it is a mere matter of computation, I am satisfied that your honor should state it to the jury. I desire to save the question of the ruling of your honor.

The COURT. Yes, sir; I intended to reserve that. Then, gentlemen, instead of troubling you with the figures I have made, I will give you but one sum. If the plaintiffs are entitled to recover, the amount that they are entitled to recover is $30,348.28 in gross, subject, of course to any correction, if it should turn out that there has been any mistake in any of these computations.

Mr. ABBOTT. I desire to ask specifically this, at the suggestion
108 of my associate. I am afraid that it might not be fully understood, although I think it was the intention of the charge. I ask your honor to charge, as to whether or not the Davis feed is a drop-feed, within the meaning of the contract, is a question of fact for the jury to decide on the evidence, and the meaning of the contract is to be determined by what kind of feed was known as drop-feed at or before the date of the contract.

The COURT, (to plaintiff's counsel.) Do you object to that?

Mr. HOAR. Not with the explanations that we should desire to put in with it. I think your honor has covered all that ground.

THE COURT. I am requested, gentlemen, to give you this additional instruction, which I believe is substantially covered in what I have stated, as to whether or not the Davis feed is a drop-feed, within the meaning of the contract; that is a question of fact for you to decide on the evidence, and the meaning of the contract is to be determined by what kind of feed was known as drop-feed at or before the date of the contract, and it is not to be restricted to a particular form in which it was applied at that date.

Upon the conclusion of the charge, the defendants requested the court to instruct the jury that whether or not the feed in the Davis machine was a drop-feed within the meaning of the plaintiffs' license, is a question of fact for the jury, to be decided upon the evidence, and the meaning of the contract is to be determined by what kind of feed was known as a drop-feed at and before the date of said license. The court said that he thought the instruction had been substantially given in what had been already stated; and so instructed them, with this addition, "that they were not to be restricted to the particular form in which it had been applied at that date."

The jury retired to consider their verdict; and after an absence of several hours, returned into court and reported through their foreman that they had agreed upon a verdict. Without receiving their verdict, the presiding judge gave them further instructions, and requested them to return an answer to the following question, viz: "Was it the understanding of the trade in February, 1868, that 'drop-feed' meant exclusively the form and mode of feed used in the defendants' machines, as distinguished from the form and mode afterwards used in the Davis machine;" and thereupon the jury again retired without delivering their verdict. The instructions thus given were as follows:

"The seventh clause was prospective in its operation. It was intended to provide for future cases or contingencies; the promise was not to license any drop-feed machine, whatever its form. Then the question is, whether drop-feed meant only such machine as was then in use, or whether it meant a particular method of feeding whatever kind of machine it might be used in, or whether it meant Wheeler & Wilson,
Singer, Grover & Baker, and Florence, as to feed, or whether it
109 meant 'four-motion feed combined with frictional pressure,' in any kind of machine, whether then in use, or that might come in use. Did it mean any kind of machine that had been or that might be got up under those patents, (so far as they related to feed,) or machines in that respect, exactly in that respect, like Wheeler & Wilson, etc., in details and arrangement. If it was understood to extend to all machines that had been or might be devised under those patents or any of them, (as to feed,) jury might answer the question submitted in the negative. The fact that the form in which drop-feed was applied was under the cloth, in all machines, in 1868, is not necessarily decisive of that question."

After further consultation the jury came into court and asked for instruction upon the question whether if, previous to February, 1868, the drop-feed had been uniformly applied in one way, namely, underneath the table, as in the Wheeler & Wilson machine, that fact would be decisive upon the question what by the usage at that time was understood as a drop-feed. The court instructed them that such fact would not be necessarily decisive as to what by the usage was then meant by a drop-feed.

The plaintiffs claimed to recover the amount of license-fees which had been paid by them to said receiver from Oct. 1, 1868, to Oct. 1, 1869, with interest thereon from the date of the several payments, after crediting the defendants with forty cents per machine for all the machines which had been *been* manufactured by them after said Oct. 1, 1868, to May , 1872.

The defendants did not consent to any credit for machines made by the plaintiffs subsequently to the date of the writ, but objected thereto.

The jury returned a verdict for the amount claimed by the plaintiffs, with interest as claimed.

To all which rulings, refusals, and instructions, the defendants duly excepted, and now pray that their exceptions may be allowed.

By ELIAS MERWIN,
Their Attorney.

The case is reported for the consideration of the whole court upon these exceptions.

SETH AMES, *J. S. J. C.*

Allowed.

SETH AMES, *J. S. J. C.*

110 And the questions of law arising under said exceptions were entered on the law docket of this court, and thereupon the parties appearing, the said defendants by their attorneys, Elias Merwin and J. G. Abbott, esquires, and the Florence Sewing-Machine Company by its attorneys, A. L. Soule, esq., and Hon. E. K. Hoar, and having been fully heard before the full bench of our supreme judicial court upon all said questions of law, the same were continued nisi, and on the 11th day of April, A. D. 1873, the following rescript was received and filed in this court:

COMMONWEALTH OF MASSACHUSETTS:

Supreme judicial court for the Commonwealth, at Boston, January term, 1873.

111 IN THE CASE OF FLORENCE SEWING-MACHINE COMPANY
vs.
GROVER & BAKER SEWING-MACHINE COMPANY.

Pending in the supreme judicial court for the county of Hampshire.

Ordered, that the clerk of said court in said county make the following entry under said case in the docket of said court, viz:

Exceptions overruled.

By the court.

GEO. C. WILDE, *Clerk.*

APRIL 10TH, 1873.

Brief statement of the grounds and reasons of the decision.

1. The petition to remove the case was rightly refused.
2. The rulings were right on all the points made by the defendants.

112 And now, at this term, to wit, on the seventeenth day of April, A. D. 1873, during said term, it is considered and adjudged by the court here that the said Florence Sewing-Machine Company, plaintiff, do have and recover of the said Grover & Baker Sewing-Machine Company, the said Wheeler and Wilson Manufacturing Company, and the said Singer Manufacturing Company, defendants, the sum of thirty-one thousand nine hundred and fifty-six dollars and seventy-three cents damages, and its costs of suit taxed in the sum of five hundred and thirty-eight dollars and seventy-nine cents, and that execution issue therefor accordingly.

Attest:

W'M P. STRICKLAND, *Clerk.*

113 COMMONWEALTH OF MASSACHUSETTS,
Hampshire, ss :

I, William P. Strickland, clerk of the supreme judicial court for said county of Hampshire, do hereby certify that the foregoing is a true and correct copy of the record of said case and of all process, pleadings, and other proceedings in said suit, no testimony or depositions having been filed therein; that the same are and are by law required to be in the custody of said clerk, and that the foregoing are true copies thereof and of the whole of such originals.

In testimony whereof I have hereunto set my hand and affixed the seal of our said supreme judicial court this twentieth day of May, in the year of our Lord one thousand eight hundred and seventy-three.

Attest:

[SEAL.] WILLIAM P. STRICKLAND, *Clerk.*

114 *Copy of bond on writ of error.*

Know all men by these presents that we, The Grover & Baker Sewing-Machine Company, a corporation of the State of Massachusetts, The Wheeler & Wilson Manufacturing Company, a corporation of the State of Connecticut, & The Singer Manufacturing Company, a corporation of the State of New York, as principals, and William O. Grover and William E. Baker, both of Boston, in the State of Massachusetts, as sureties, are held and firmly bound in the full and just sum of one hundred thousand dollars unto The Florence Sewing-Machine Company, a corporation of said State of Massachusetts, to be paid to the said Florence Sewing-Machine Company, its certain attorney or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these presents, sealed with our seals, and dated the nineteenth day of April, in the year of our Lord one thousand eight hundred and seventy-three.

Whereas lately, at a term of the supreme judicial court within and for the county of Hampshire & State of Massachusetts, namely, on the seventeenth day of April, A. D. 1873, in a suit depending in said court between the said Florence Sewing-Machine Company as plaintiff, and the said Grover & Baker Sewing-Machine Company, the said Wheeler & Wilson Manufacturing Company, and the said Singer Manufacturing Company, as defendants, judgment was rendered against the said

defendants, and the said Grover & Baker Sewing-Machine Company, the said Wheeler & Wilson, and the said Singer Manufacturing Companies, having procured a writ of error, and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit, and a citation directed to the said Florence Sewing-Machine Company, citing and admonishing it to be and appear at a Supreme Court of the United States, to be holden at Washington on the second Monday of October next:

Now, the condition of the above obligation is such, that if the said Grover & Baker Sewing-Machine Company, the said Wheeler & Wilson, and the said Singer Manufacturing Companies shall prosecute their said writ of error to effect, and answer all damages and costs if they fail to make their plea good, then the above obligation to be null and void; otherwise to remain in full force and virtue.

(Signed) GROVER & BAKER S.-M. Co., [L. S.]
By W. O. GROVER, *Treas'r.*
WHEELER & WILSON M'F'G COMP'Y, [L. S.]
By N. WHEELER, *Pres't.*
THE SINGER M'F'G CO., [L. S.]
By G. R. MCKENSIE, *Vice-President.*
W. O. GROVER. [L. S.]
W'M E. BAKER. [L. S.]

Signed, sealed, and delivered in presence of—
JOHN W. RIPLEY to the Singer M'f'g Company & Wheeler & Wilson M'f'g Company.
ELIAS MERWIN to W. O. G. & W. E. B.

Approved.

R. A. CHAPMAN,
Chief Justice S. J. C.

A true copy of the bond taken by the judge at the time of allowing the writ of error named in said bond, which bond is on file in the office of the clerk of the supreme judicial court for the county of Hampshire, and State of Massachusetts.

Attest:

WILLIAM P. STRICKLAND, *Clerk.*

(Indorsed:) 6. Grover & Baker S.-M. Co. & al., pl'fs in error, vs. The Florence Sew'g-M. Co., def'ts in error. Copy of bond filed by pl'fs in error. Hampshire, ss. S. J. C. Filed April 24, 1873. Attest, W'm P. Strickland, clerk.

115 The United States of America to The Florence Sewing-Machine Company, a corporation established and doing business in the State of Massachusetts, greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington on the second Monday of October next, pursuant to a writ of error filed in the clerk's office of the supreme judicial court for the county of Hampshire & Commonwealth of Massachusetts, wherein The Grover & Baker Sewing-Machine Company, The Wheeler & Wilson Manufacturing Company, & The Singer Manufacturing Company are plaintiffs in error, and you are defendant in error, to show cause, if any there be, why judgment ren-

dered against the said plaintiffs in error, as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness the honorable Reuben A. Chapman, chief justice of the supreme judicial court of the Commonwealth of Massachusetts, this nineteenth day of April, in the year of our Lord one thousand eight hundred and seventy-three.

REUBEN A. CHAPMAN,
Chief Justice S. J. C.

116 U. S. OF AMERICA,
Mass. Dist., ss :

BOSTON & FLORENCE, *April 29th*, 1873.

I hereby certify that I have this day served the within citation by giving in hand to Sidney Strong, treasurer of the within-named Florence Sewing-Machine Company, a true and attested copy of this precept.

R. G. USHER,
U. S. Marshal.

Fees: Service, $2; travel, 7.50; copy, 1.00—10.50.

117 UNITED STATES OF AMERICA, *ss :*

[SEAL.] The President of the United States to the honorable the judges of the supreme judicial court of the Commonwealth of Massachusetts, greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea, which is in the said supreme judicial court before you, or some of you, being the highest court of law or equity of the said State in which a decision could be had in the suit between The Florence Sewing-Machine Company, a corporation, plaintiff, and The Grover & Baker Sewing-Machine Company, The Wheeler & Wilson Manufacturing Company, & The Singer Manufacturing Company, defendants, wherein was drawn in question the validity of a treaty or statute of, or an authority exercised under, the United States, and the decision was against their validity, or wherein was drawn in question the validity of a statute of, or authority exercised under, said State on the ground of their being repugnant to the Constitution, treaties, or laws of the United States, and the decision was in favor of such their validity; or wherein was drawn in question the construction of a clause of the constitution, or of a treaty, or statute of, or commission held under the United States, and the decision was against the title, right, privilege, or exemption specially set up or claimed under such clause of the said constitution, treaty, statute, or commission, a manifest error hath happened, to the great damage of the said Grover & Baker Sewing-Machine Company, & the said Wheeler & Wilson, & Singer Manufacturing Companies, as by their complaint appears, we being willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at Washington on the second Monday of October next, in the said Supreme Court to be then and there held, that the record and proceedings aforesaid being inspected,

the said Supreme Court may cause further to be done therein to correct that error what of right and according to the laws and customs of the United States should be done.

Witness the honorable Salmon P. Chase, Chief Justice of the said Supreme Court, this nineteenth day of April, in the year of our Lord one thousand eight hundred and seventy-three.

JOHN G. STILSON,
Clerk of the Circuit Court of the United States.

Allowed by—

REUBEN A. CHAPMAN,
Chief Justice S. J. C.

118 COMMONWEALTH OF MASSACHUSETTS,
Hampshire, ss:

And now the judges of the supreme judicial court of said Commonwealth make return of this writ by annexing hereto and sending herewith, under the seal of said court, as within commanded, a true and attested copy of the record and process in the suit within mentioned, and of all papers filed therein, and of all proceedings therein, and the original citation to the defendants in error, with the service endorsed thereon, and also a copy of the bond to prosecute the said writ of error, the original of which remains on file in this office.

In testimony whereof I, William P. Strickland, clerk of said court within and for said county of Hampshire, have hereunto set my hand and the seal of said court this twentieth day of May, in the year of our Lord eighteen hundred and seventy-three.

[SEAL.] WILLIAM P. STRICKLAND, *Clerk.*

(Endorsed:) 6. Grover & Baker S.-M. Co. & al., pl'fs in error, vs. Florence S.-M. Co., def't in error. Writ of error. Hampshire, ss. S. J. C. in vac. Filed April 24, 1873. Attest: W'm P. Strickland, clerk.

(Indorsement on cover:) No. 451. The Grover & Baker Sewing-Machine Company, The Wheeler & Wilson Manufacturing Company, and The Singer Manufacturing Company, plaintiffs in error, vs. The Florence Sewing-Machine Company. Massachusetts sup. jud'l court. Filed 16th July, 1873.

Supreme Court of the United States.

No. 451.

THE GROVER AND BAKER SEWING MACHINE COMPANY, THE WHEELER AND WILSON MANUFACTURING COMPANY, AND THE SINGER MANUFACTURING COMPANY,

PLAINTIFFS IN ERROR.

vs.

THE FLORENCE SEWING MACHINE COMPANY.

BRIEF OF PLAINTIFFS IN ERROR.

ALFRED MUDGE & SON, LAW PRINTERS, 34 SCHOOL STREET, BOSTON.

Supreme Court of the United States.

No. 451.

THE GROVER & BAKER SEWING MACHINE CO. ET AL.,

PLAINTIFFS IN ERROR,

vs.

THE FLORENCE SEWING MACHINE COMPANY.

BRIEF OF PLAINTIFFS IN ERROR.

STATEMENT OF CASE.

THIS is a writ of error to the Supreme Judicial Court of the State of Massachusetts.

The suit was originally brought by the Florence Sewing Machine Company (Defendant in Error), a Massachusetts Corporation, against the Grover & Baker Sewing Machine Company, also a Massachusetts Corporation, the Wheeler & Wilson Manufacturing Company, a Connecticut Corporation, and the Singer Manufacturing Company, a New York Corporation.

The writ was returnable to the April Term of said Court for the year 1871, held at Northampton in the County of Hampshire.

The action was contract (*assumpsit*), in which the Florence Sewing Machine Company sought to recover of the three defendant corporations an alleged over-payment which the plaintiff claimed it had made to the defendant corpora-

tions under a license agreement which had been granted by the latter to the former. Due service of the writ was made upon all the defendants, according to the laws of the State of Massachusetts; upon the two foreign corporations by attachment of the property of each within the State, by service of a summons upon an agent of each within the State, and also by publication of notice in a newspaper.

The writ is in Record, p. 1; the plaintiffs' declaration, Record, p. 3; the agreements referred to in the declaration, Record, pp. 4 to 8.

The Grover & Baker Sewing Machine Company appeared at the April Term, 1871, by counsel, and filed its answer. Record, pp. 9, 10.

At the April Term, 1872, the Wheeler & Wilson Manufacturing Company, and the Singer Manufacturing Company, appeared by counsel, and respectively filed answers. Record, pp. 12, 13, 14.

At said April Term, 1872, namely, on the 16th day of April, 1872 (Record, p. 14), and before the trial of said case, the Wheeler & Wilson Manufacturing Company filed its petition for the removal of said cause to the Circuit Court of the United States for the District of Massachusetts, for the reason that the plaintiff corporation was a citizen of the State of Massachusetts, that said defendant corporation was a citizen of the State of Connecticut, that a controversy existed between them in said suit, and that the petitioner had reason to believe, and did believe, that from prejudice and local influence, it would not be able to obtain justice in said State Court. An affidavit to this effect was also made in its behalf by its president, and filed; and also a bond with sufficient sureties as required by law.

The petition is in Record, pp. 15, 16; Affidavit of President, p. 16; Bond, pp. 16, 17.

On the same day (Record, p. 17 ad. fin.) a similar petition, affidavit, and bond were made and filed by and in behalf of the Singer Manufacturing Company.

Petition, Record, pp. 18, 19; Affidavit, p. 20; Bond, pp. 20, 21.

Subsequently, at the same term and before the trial of the cause, these petitions were heard before the presiding judge of said Court, and he refused the same, and ordered the case to proceed to trial; and the defendants filed exceptions thereto. Record, pp. 22, 23.

The case proceeded to a trial, and the jury returned a verdict for the plaintiff corporation. Record, p. 23.

The defendants took several exceptions during the trial to the rulings and instruction of the judge, and the bill of exceptions, as filed, and allowed, is set forth in the Record, p. 24 to p. 39.

The only exception material now to be noticed is thus stated and allowed by the judge. Record, p. 24.

"This was an action of contract. The pleadings are made a part of the case. The plaintiff is a Massachusetts corporation; the defendants are the Grover & Baker Sewing Machine Company, a Massachusetts corporation; the Wheeler & Wilson Manufacturing Company, a Connecticut corporation; and the Singer Manufacturing Company, a New York corporation. Before the trial of the case, the Wheeler & Wilson Manufacturing Company, and the Singer Manufacturing Company, filed several petitions for the removal of said case to the Circuit Court of the United States, under the United States Statutes of March 2, 1867, chap. 196, together with affidavits and other papers filed therewith, and a hearing was had on said petitions. The Court refused to grant the petitions, and ordered the case to proceed to trial, reserving the question for the consideration of the whole Court."

This exception, with others, was heard before the full bench of the Supreme Judicial Court of Massachusetts, and upon the eleventh day of April, A. D. 1873, a rescript was entered, overruling all the exceptions. Record, p. 39. The language of the Court is as follows: —

"1. The petition to remove the case was rightly refused."

"2. The rulings were right on all the points made by the defendants." Record, p. 40.

On April 17, 1873, final judgment was entered for the plaintiff (Record, p. 40), and on the nineteenth day of the same April, this writ of error was allowed. (Record, pp. 42, 43.)

ASSIGNMENT OF ERRORS.

The only error which the plaintiffs in error consider it proper or material to submit to the consideration of this Court at present, is that which relates to the action of the State Court in refusing to allow the petitions for a removal of the cause to the United States Court, and in proceeding to try and determine the case. Record, pp. 22, 23; also Record, p, 24, and Brief, p.

If the cause was removable to the United States Court, then all the proceedings of the State Court thereafter were a mere nullity; and as the case will not be remitted to it for another trial, its rulings on the trial become immaterial. If the cause was not removable, and the State Court had jurisdiction of it, this Court will not revise the rulings or instructions upon the trial.

BRIEF.

The question thus presented on this Record, is whether a case in which the plaintiff is a citizen of the State where the suit is brought, and two of the defendants are citizens of other States, a third defendant being a citizen of the same State as the plaintiff, is removable to the United States Circuit Court upon the petition of the two foreign defendants under the United States Statute of March 2, 1867, chap. 196, 14 Stat. at Large, 558, upon their complying with the several requirements of that Statute; or whether the judicial power and the right of removal are confined to cases where the parties on one side are all citizens of one State, and the parties on the other side are *all* citizens of another State.

The plaintiffs in error maintain that under the Constitution, and the law of Congress, this case was removable, and consequently that it was error in the State Court to retain and try it.

Three inquiries are involved in this discussion.

1. The extent of the judicial power of the United States under the Constitution of the United States.

2. The extent to which Congress has made provision for the exercise of that power, by the act in question (March 2, 1867, ch. 196).

3. Is the present case within the terms of that act.

First.

The judicial power conferred by the Constitution covers this case; and is not limited to cases where the plaintiff is a citizen of one State, and all the defendants are citizens of some other State.

The provision is as follows: Cons. Art, III. ~~etc.~~ Sec. 2. "The judicial power shall extend . . . to *controversies* between citizens of different 'States.'

The language is most comprehensive, and the jurisdiction which it confers necessarily includes any and every judicial controversy which may exist between citizens of different States, although others may be parties to the same controversy. It is none the less a controversy between citizens of different States, because others are also parties to it, and therefore to confine the Federal jurisdiction to cases wherein the controversy is between citizens of different States *exclusively*, is to interpolate into the Constitution a word not placed there by those who ordained it, and one which very materially limits and controls its express provisions.

One of the great objects of this article of the Constitution was to allay apprehensions of injustice from State prejudice, and to "form a more perfect union," by holding out to every citizen of the United States the assurance that in all judicial controversies between himself and the citizen of any other State, his controversy might be tried and determined by an

impartial tribunal, and one in reference to which no fear could exist that it would be biased in favor of his adversary, by any local prejudices or considerations.

The judicial power is coextensive with the subject-matter to which it relates, *i. e.*, any and every judicial controversy between citizens of different States, or in which (to adopt the language of the Federalist, *seq.*) *they are concerned as parties.*

The terms of the grant are full, general, and unequivocal, and were made so designedly; in order that the power might be commensurate with every possible exigency. The Constitution does not descend to details. It remits to Congress the duty to create (with one exception) the necessary Federal tribunals; to prescribe under what circumstances and in what mode their jurisdiction shall be exercised; and also to determine from time to time, in view of the condition of the country, under what restrictions it shall be exercised; and whether or not, the necessary or unnecessary joinder of other parties shall deprive a citizen of the opportunity to have his controversy with the citizen of another State, tried by the National tribunal. The Federalist in discussing this article of the Constitution, first treats of the absolute necessity of a National tribunal for the decision of controversies in which foreigners are concerned, and then proceeds thus:—

"The power of determining causes between two States, between one State and the citizens of another, and between the citizens of different States, *is perhaps not less essential to the peace of the Union, than* that which has been just examined. . . . A method of terminating territorial disputes between the States, under the authority of the federal head, was not unattended to, even in the imperfect system by which they have hitherto been held together. But there are other scources, besides interfering claims of boundary, from which bickerings and animosities may spring up among the members of the Union. . . .

"It may be esteemed the basis of the Union, that the citizens of each State shall be entitled to all the privileges and

immunities of citizens of the several States.' And if it be a just principle, that every government ought to possess the means of executing its own provisions by its own authority, it will follow that in order to the inviolable maintenance of that equality of privileges and immunities to which the citizens of the Union will be entitled, the National judiciary ought to preside in all cases in which one State or its citizens are opposed to another State or its citizens. To secure the full effect of so fundamental a provision *against all evasion and subterfuge*, it is necessary that its construction should be committed to that tribunal, which, having no local attachments, will be likely to be impartial between the different States and their citizens, and which, owing its official existence to the Union, will never be likely to feel any bias inauspicious to the principles on which it is founded."

Federalist, No. 80.

Vide et Story. Story, Com. Const., Secs. 1690, 1691, 1692.

A construction which would forever preclude the possibility of a resort to a federal tribunal in controversies between citizens of different States, simply for the reason that in the same case there was also a controversy between citizens of the same State, would be in derogation of the express terms of this provision of the Constitution, and subversive of the great purposes which it intended to secure.

(2.) Such a construction would put it in the power of the plaintiff always to deprive the citizen of another State of the right to a trial of his controversy in the federal tribunal, by merely joining with him as co-defendant a citizen of the plaintiff's State. And thus the power to determine in which tribunal the controversy shall be tried, whether in the local and prejudiced one, or in the federal and impartial one, is forever committed to the very party against whom it was the sole purpose of this constitutional provision to afford protection.

(3.) The language used in other clauses of Art. III confirms the view that the term "*controversies*," as used in this

particular clause, was so employed for a purpose, and in distinction to the word "suit" or "case."

The former part of the section speaks of "all cases in law or equity," etc.; but here the phraseology is changed *ex industria* to "*controversies*."

A controversy between citizens of different States must exist in the suit, — and, if so, the jurisdiction will attach, — but the suit or case may not be between them exclusively. There may be other parties to it.

(4.) The same rule of construction which is applied to this clause, must govern the other clauses of this section. They are in *pari materia*. A reference to these clauses will show that the proposed limitation cannot be engrafted on this article without in effect annulling it.

Art. III provides that the judicial power shall extend "to all cases affecting ambassadors, other public ministers, and consuls."

Can it be pretended that this jurisdiction can be defeated by joining some one else as a party with an ambassador, public minister, or consul; or because the case may affect some one else than those officers. 6. Watch 315

The article provides that the judicial power shall extend "to all controversies between two or more States." Can this jurisdiction be defeated, by joining as a party defendant, a private person or corporation?

It also provides that, "the judicial power shall extend to all cases in law and equity, arising under this Constitution, *the laws of the United States*, and treaties made, or which shall be made, under their authority."

Does not the jurisdiction exist in a case because other questions are involved in it than those arising under the Constitution laws or treaties of the United States? This was settled in the case of Osborn *vs.* United States Bank, 9 Wheat. 738. *

The precise question there raised was, whether the act of Congress, so far as it authorized the United States Bank (created by a law of the United States) to sue in any Circuit

* The Mayor v. Cooper 6 Wall 252

Court of the United States, was constitutional. The defendant contended that it was not, and that the suit in question was not a "suit," or "case," within the meaning of the Constitution, or of the act of Congress, because several questions might arise in it which would depend on the general principles of the law, and not on any act of Congress. In other words, it was there attempted, as it is now attempted by the defendants in error, to add to this clause of the Constitution, the word "*exclusively*."

But in dealing with the argument, that other questions than those arising under a law of Congress, arose in the case, and therefore the judicial power did not extend to it, Marshall, Ch. J., said: —

"If this were sufficient to withdraw a case from the jurisdiction of the Federal Courts, almost every case, although involving the construction of a law, would be withdrawn; and a clause in the Constitution relating to a subject of vital importance to the Government, and expressed in the most comprehensive terms, would be construed to mean almost nothing. . . . If their existence (other questions) be sufficient to arrest the jurisdiction of the Court, words which seem intended to be as extensive as the Constitution, laws, and treaties of the Union, which seem designed to give the Courts of the Government the construction of all its acts, so far as they affect the rights of individuals, would be reduced to almost nothing."

We respectfully submit that this decision applies to the provision now under discussion, and furnishes the true rule for its construction.

We may well repeat, in reference to it, the language of Ch. J. Marshall, that if the mere joining of another party were sufficient to withdraw a controversy between citizens of differen States, from the jurisdiction of the federal courts, almost every case would be withdrawn; and a clause in the constitution relating to a subject of vital importance, *and expressed in the most comprehensive terms*, would be construed to mean almost nothing.

The cases are parallel. The federal jurisdiction is made by the Constitution to depend upon one of two things, either the nature of the subject-matter of the controversy, or the character of the parties to the controversy. It extends to every case in which a question arises under its own laws, or in which a controversy exists between citizens of different States. Either one of these conditions confers the jurisdiction, and it cannot be defeated because other questions or other parties are involved in the controversy.

To the same effect is the language of this Court in Railway Company *vs.* Whiton, 13 Wall. 288. "The judicial power of the United States extends, by the Constitution, *to controversies between citizens of different States as well as to cases* arising under the Constitution treaties and laws of the United States, and the manner and conditions upon which that power shall be exercised, except as the original or appellate character of the jurisdiction is especially designated in the Constitution, are mere matters of legislative discretion."

A similer view was held by Nelson, J., in reference to the Act, July 27, 1868, 15 U. S. Stat. at Large, 226, authorizing a removal by a corporation created by Congress, or any member thereof, of a case to the United States Court under certain circumstances. 6 Blatch 243

After referring to the case of Osborn *vs.* U. S. Bank, *sup.*, Nelson, J., says:—

"For the same reasons I am of opinion, that the joining of defendants in a suit, not within the limitation as prescribed by the act with those who are, cannot be permitted to withdraw the cause from the jurisdiction of the federal Courts. If this were admitted, the privilege extended to the parties setting up a right under the Constitution and laws of the United States, would, in most, if not in every instance, be defeated."

Florence S. M. Co. *vs.* Grover & Baker S. M Co., in United States Circuit Court, Mass. Opinion of Shepley, J.

6 Blatch 378

(5.) The decisions made under the Judiciary Act of 1789, secs. 11 and 12 (1 St. at Large, 78 and 79), do not conflict with the views here presented.

As, Strawbridge & al. *vs* Curtis & al., 3 Cranch, 267.
New Orleans *vs.* Winter & al., 1 Wheat. 92.

Those cases all relate to the proper construction of the Judiciary Act, and not of the clause of the Constitution.

The eleventh section limited the jurisdiction of the Circuit Court to suits where an alien is a party, "or the *suit* is between a citizen of the State where the suit is brought, and a citizen of another State."

And the twelfth section limited the right of removal to "a *suit* commenced in any State Court, against an alien, or by a citizen of the State in which the suit is brought against a citizen of another State."

As said by Marshall, Ch. J. (3 Cranch, *sup.*), these expressions were understood "to mean that each distinct interest should be represented by persons, all of whom are entitled to sue, or may be sued in the federal courts, — that is, that where the interest is joint, each of the persons concerned in that interest must be competent to sue, or liable to be sued in those Courts."

But the Judiciary Act industriously employed the word "suit" throughout, in distinction from the broader term "controversy," used in the Constitution; and it was also expressly confined to a suit between a citizen of the State where the suit is brought, and a citizen of another State.

Nor can it be claimed for this act that it was a contemporaneous declaration of the view entertained by Congress as to the extent of the judicial power created by the Constitution. It has never been so claimed or understood. On the contrary, it is obvious, as has been frequently stated in judicial opinions, that the Judiciary Act did not exhaust the judicial power; and it went only so far as the condition of the country, in the opinion of Congress, then seemed to require or render expedient.

For instance, under the 11th and 12th sections, no suit could be brought in, or removed to the United States Circuit, unless it was a suit between a citizen of the *State where the suit was brought* and a citizen of another State; and yet no one can doubt that the jurisdiction might have been extended, in either case, to suits between citizens of different States, although neither was a citizen of the State where the suit was brought.

Highly respectable courts have fallen into grave error, by confounding the Judiciary Act with the Constitution, and by quoting the decisions of this Court in reference to that act, as interpretations of the Constitution.

Ex. qr. Bryant *vs.* Rich, 106 Mass. R. 192.

The rule of interpretation which should govern in this instance, is thus stated by Story, J.: —

"Where the power is granted in general terms, the power is to be construed as coextensive with the terms, unless some clear restriction upon it is deducible from the context. . . . *A restriction founded on conjecture is wholly inadmissible.*

1 Story Com. Const. sec. 424.
Loughborough *vs.* Blake, 5 Wheat. 317.
United States *vs.* Marigold, 9 How. 560.

SECOND.

CONSTRUCTION OF STATUTE MARCH 2, 1867, 14 STAT. AT LARGE, 558.

Having thus ascertained that the provision of the Constitution confers federal jurisdiction over cases like the present, we are next to inquire whether Congress has provided for the exercise of that jurisdiction by the act of March 2, 1867.

It is as follows: —

"*Be it enacted*, That the act entitled 'an act for the removal of causes in certain cases from State Courts,' approved July 27, 1866, be and the same is hereby amended as follows: That where a suit is now pending, or may hereafter

be brought in any State Court, in which there is controversy between a citizen of the State in which the suit is brought and a citizen of another State, and the matter in dispute exceeds the sum of five hundred dollars, exclusive of costs, such citizen of another State, whether he be plaintiff or defendant, if he will make and file in such State court an affidavit, stating that he has reason to and does believe, that from prejudice or local influence, he will not be able to obtain justice in such State Court, may at any time before the final hearing or trial of the suit, file a petition in such State Court for the removal of the suit into the next Circuit Court of the United States, to be held in the district where the suit is pending, and offer good and sufficient surety for his entering in such court on the first day of its session, copies of all process, pleadings, depositions, testimony and other proceedings in said suit, and doing such other appropriate acts as, by the act to which this act is amendatory, are required to be done upon the removal of a suit into the United States Court; and it shall be, thereupon, the duty of the State Court to accept the surety and proceed no further in the suit; and the said copies being entered as aforesaid in such Court of the United States, the suit shall there proceed in the same manner as if it had been brought there by original process," etc.

It was settled by this Court in Railway Co. *vs.* Whitten, 13 Wall. 270, that this act in providing for a removal of a cause at the time and under the circumstances stated in the act was constitutional, and also that corporations were embraced within the constitutional provision relating to controversies between citizens of different States.

But the precise point now before the Court did not arise, and was not passed upon in that case.

If, however, we have ascertained the true meaning and scope of the words in the constitution, "controversies between citizens of different States," there can be no doubt as to the true meaning of the act of 1867, nor of its application to the present case. For, that act departing from the

limited and technical phraseology employed in the preceding statutes, employs, for the first time, the more comprehensive language of the Constitution, and legislates concerning "*controversies* between citizens of different States."

I. This act was designed to, and does in terms very clearly provide for the removal of a suit, for cause, from a State Court, to the United States Court, upon the petition of a defendant who is a citizen of a different State from that of the plaintiff, where the suit is brought, although there are other parties, defendant, who are citizens of the same State as the plaintiff.

This is apparent from the language of the act itself, and from the previous legislation upon this subject.

The Judiciary Act, 1789, ch. 20, sec. 12, confined the right of removal to suits commenced "by a citizen of the State in which the suit was brought against a citizen of another State"; and also required that the petition for removal should be filed by the defendant at the time of entering his appearance.

This provision, as was uniformly held, applied only to a suit between a citizen of the State in which the suit was brought and a citizen of some other State, and clearly did not apply to a case where a resident defendant was also a party.

In 1866, however, a very important change took place in the legislation upon this subject, and Congress then began, under the pressure of a new exigency, to secure more completely, by appropriate legislation, to non-resident defendants, their constitutional right to have their controversies tried in the federal tribunals.

The act of 1866, ch. 288, 14 Stat. L. 306, for the first time made provision for the removal of a suit to the federal court by a non-resident defendant, although a citizen of the State where the suit was brought was also a defendant therein.

That act made two changes in the previous law. First, it allowed the cause to be removed to the federal court so far

as the non-resident defendant was concerned, "if the suit was one in which there could be a final determination of the controversy, so far as it concerned him, without the presence of the other defendants as parties in the cause," but leaving the suit in the State court so far as it related to the resident defendant; and secondly, it allowed the petition for removal to be filed at any time before the trial, instead of requiring it to be filed with the defendants' first appearance, as in the Judiciary Act.

It was soon apparent that this act could not effect much practical change or relief, as the number of cases to which it could be applicable was very limited indeed, as cases seldom arise "in which there can be a final determination of the controversy as to one co-defendant without the presence of the other defendants as parties in the cause."

Accordingly, in pursuance of the policy indicated by that act, to provide what was supposed to be a more impartial tribunal for non-resident defendants in every case, Congress passed the act of March 2, 1867, to supply the obvious deficiencies of the Stat. of 1866, and to allow a non-resident to remove the cause to the federal tribunal, whenever he had reason to believe that from prejudice, or local influence, he would be unable to obtain justice in the State courts, although there were other co-defendants who were residents of the State in which the suit was brought.

The statute of 1867 cannot be confined to those cases where non-residents are the only defendants without violating its language and intent.

(*a.*) It is an act "*to amend the act of* 1866." Now, the sole purpose of the act of 1866 was to provide for a removal of suits in behalf of non-resident defendants in those cases in which *resident* parties were also defendants. The obvious purpose of the statute of 1867 was to add another case to the list, which might be removed by non-resident defendants, although resident parties were also defendants; and it was thus, as it professed to be, and thus only could it be, an amendment of the act of 1866.

Neither the act of 1866, nor the Judiciary Act, sec. 12, is repealed by the statute of 1867. All subsist, and each provides for a distinct case, viz. : —

The statute of 1789, for removal where the defendants are all non-residents; the statute of 1866, where part only are non-residents, but the cause is divisible as to them; the statute of 1867, where part only are also non-residents, but where local prejudice exists, and for that reason the entire cause is made removable.

(*b.*) Under statute of 1789, sec. 12, non-residents (if the only parties defendant) can now remove a case to the federal tribunal, under the provisions of that act, without affidavit, and without the cause of local prejudice. If the statute of 1867 is also to be confined to the same class of cases (where all the defendants are non-residents), then, as it requires cause and affidavit for removal, it is a restriction upon the right of removal as originally given by the statute of 1789,— a result which is obviously absurd.

(*c.*) The peculiar phraseology of the statute of 1867, fairly admits of no other interpretation than that which we give it.

The language is, that "when a suit is now pending, or may hereafter be brought in any State Court, *in which there is controversy between a citizen of the State in which the suit is brought, and a citizen of another State*," etc.

The language italicized is used for the first time in this act, and is very significant.

The language of the statute of 1789 was, "if a suit be commenced *by a citizen* of the State, etc., against a citizen of another State," etc.; but here the striking phrase is, "where a suit is now pending . . . *in which there is controversy between* a citizen," etc.

This language excludes the idea that the suit must necessarily be one in which all the parties on one side are citizens of one State, and all the parties on the other are citizens of another State. It is enough, however the parties may be distributed as to citizenship, if in the suit there is contro-

versy between a citizen of one State as plaintiff, and a citizen of another as one of the defendants. If there are these parties to the controversy, the right of removal exists, although there may be other parties to the suit and the controversy.

The statute does not limit the right of removal to the case where a citizen of one State, as plaintiff, and the citizen of another State, as defendant, are the only parties to the controversy.

Vide et St. 1868, ch. 255, sec. 2, 15 Stat. at L. 226.
Johnson *vs.* Monell, Woolworth C. C. 390.
Fields *vs.* Lamb *et al.*, Deady C. C. 430.
Sands *vs.* Smith, 1 Dillon, 290.

The decision of Blatchford J. in Bixley *et al. vs.* Chase *et al.*, 8 Blatch. 73, and of Dillon J. in 1 Dillon R. 299, and other similar decisions, proceed upon the mistaken assumption that the statutes of 1789 and 1867 are substantially alike, overlooking the radical change which the latter statute makes, and was intended to make.

Vid Opinion of Shepley J. in Florence S. M. Co. *vs.* Grover & Baker S. M. Co. *et all.*, *U. S. Circuit Court, Mass.*

THIRD.

The present case is within the act of March 2, 1867, and it was error in the State Court to retain the cause and refuse its removal.

(1.) Two of the defendants, the Wheeler & Wilson Manufacturing Company, and the Singer Manufacturing Company, were citizens of different States to that of the plaintiffs; and, although corporations, were entitled to the benefits of this act.

Railway Company *vs.* Whitten, 13 Wallace, 270.
Ohio & Miss. R. R. Co. *vs.* Wheeler, 1 Black, 286.
Lexington *vs.* Butler, 14 Wall. 282.

Those defendants (plaintiffs in error), before the trial filed, simultaneously, their petitions, affidavits, and bonds, for the removal of the case to the United States Court, and complied with all the requirements of the act.

The petition, affidavit, and bond, of the Wheeler & Wilson Manufacturing Company are in Record, pp. 15, 16, and 17; and those of the Singer Manufacturing Company in Record, pp. 18, 19, 20, 21.

(2.) No objection exists to the form of the bond. The original defendants, notwithstanding the order of the State Court, entered the case by proper copies, at the next term of the United States Circuit Court. The Florence Sewing Machine Company (defendant in error), moved in the United States Court to dismiss the case. That motion was overruled by the presiding judge, Shepley, J., and his opinion is filed herewith.

At that hearing the Florence Sewing Machine Company objected to the form of the bond, that as the condition was for the entry of the cause in the United States Court, at the session next ensuing after the order for its removal by the State Court, if the State Court made no order, or none allowing its removal, there was no obligation in the bond to enter the case at all in the United States Court.

This objection was overruled by the United States Court, and is obviously without merit.

The statute requires that a petition shall be presented to the State Court for the removal; upon that petition the State Court must take action, and pass an order, either allowing or refusing it; and if it improperly disallows the petition, such order is the basis of an exception and *of a writ of error to this Court*.

Kanouse *vs.* Martin, 14 How. 23.
S. C. 15 How. 198.

Such an order was passed by the State Court in this case — Record, p. 24 — and upon it this writ of error is based.

The proper time to enter a cause in the United States Court

which is removed from a State Court, is on the first day of its session next *ensuing after the action and order of the State Court thereon*. But that session is not necessarily the session next ensuing after *the date* of the petition and bond, for a term of the United States Court may intervene between the date of the petition and bond, and any term of the State Court at which said petition can be presented or passed upon.

"Order for removal" in this connection obviously means and should be construed to mean "order respecting removal." The intention of the parties will thus be satisfied and a fair interpretation put upon the terms of the bond. Otherwise, the strange and harsh conclusion will be reached that the bond was meant not to operate in the event of an order denying the prayer of the petition; although all the proceedings of the petitioners were taken with the view to that contingency, and with the intent to secure, ultimately, their right to remove, notwithstanding such adverse order of the State Court.

Respectfully submitted by

ELIAS MERWIN,

Of Counsel with Plaintiffs in Error.

United States Circuit Court,

DISTRICT OF MASSACHUSETTS.

THE FLORENCE SEWING MACHINE COMPANY,

vs.

THE GROVER & BAKER SEWING MACHINE COMPANY, *et al.*

DECISION OF JUDGE SHEPLEY.

NEW YORK:
BROWN & HEWITT, PRINTERS, 30 FRANKFORT ST.
1873.

Circuit Court of the United States,

MASSACHUSETTS DISTRICT.

THE FLORENCE SEWING MACHINE COMPANY,

vs.

THE GROVER & BAKER SEWING MACHINE COMPANY, ET. AL.

SHEPLEY, *J.*—The second section of the third article of the constitution extends the judicial power of the United States to controversies "between citizens of different states." There are no words in this grant of judicial power restricting it to controversies in which citizens of different states *are the sole parties.* Nor are there to be found any words of limitation which would deprive Congress of the power to confer upon the Federal Courts jurisdiction over a judicial controversy between citizens of different states arising in a suit or case, although all the persons constituting the party on one side of the case were not citizens of states different from the states of which the persons composing the other party to the suit or case were citizens. The judicial controversy contemplated by the constitution is not limited to one in which citizens of different states are *exclusively* interested. The grant of jurisdiction is not over "suits" or "causes" between citizens of different states, but over "*controversies*" between citizens of different states. Whenever, therefore, a case or suit is pending in which there is involved a judicial

"controversy" between citizens of different states, the case is one coming clearly within the terms of the constitutional grant of judicial power, although in the same case there may be a controversy between citizens of the same state. In all the debates in the convention which framed the constitution, it seems to have been admitted by all the members of the convention that the jurisdiction of the national judiciary should embrace every subject which might endanger the national peace by reason of the relations of the respective states to each other, and of their citizens to the citizens of other states. Before the conclusions of the convention had been reduced to the form of a written constitution, a resolution had unanimously passed the convention, "That the jurisdiction of the national judiciary shall extend" (among other things) "to questions which involve the national "peace or harmony."

"Nothing," says Mr. Justice Story, "can conduce more to "general harmony and confidence among all the states than a "consciousness that such controversies are not exclusively to be "decided by state tribunals, but may, at the election of the "party, be brought before the national tribunal, and if justice "should be as fairly and as firmly administered in the former as "in the latter, still the mischief would be most serious if the "public opinion did not indulge such a belief. Justice, in cases "of this sort, should not only be above all reproach but above "all suspicion. The sources of state irritations and state jeal-"ousies are sufficiently numerous without leaving open one so "copious and constant as the belief or dread of wrong in the "administration of state justice." "Probably," he subsequently remarks, "no part of the judicial power of the Union has been "of more practical benefit, or has given more lasting satisfaction

"to the people. There is not a single state which has not at "some time felt the influence of this conservative power; and "the general harmony which exists between the state courts "and the national courts in the concurrent exercise of their "jurisdiction in cases between citizens of different states, demon- "strates the utility as well as the safety of the power. Indeed, "it is not improbable that the existence of the power has operated "as a silent but irresistible check to undue state legislation, at "the same time that it has cherished a mutual respect and confi- "dence between the state and national courts, as honorable as "it has been beneficent."

This clause in the constitution was intended to protect citizens of different states from danger of injustice in the state courts through local influence or prejudice. An interprétation is contended for which would take from Congress forever the power to legislate so as to bring under its protection citizens of other states, whenever the nature of the controversy required or permitted the joinder with them, as parties, of persons who were citizens of the same states as the person or persons composing the opposite party. Such a construction would manifestly impair the end which the clause was designed to attain. The basis of the Union is in the constitutional provision that "the citizens "of each state shall be entitled to all the privileges and immu- "nities of citizens of the several states." It is essential to the upholding of any government that it should possess the power and the means of executing its own provisions by its own authority. To secure the inviolable maintenance of that equality of privileges and immunities guaranteed by the constitution to the citizens of the Union, it may be necessary whenever a controversy arises in which one state, or its citizens, are opposed to

another state, or its citizens (whether the controversy be or not *exclusively* confined to different states or the citizens of different states), to commit it to that tribunal, which, having no local attachment, will be likely to be impartial between the different states and their citizens, and which, owing its official existence to the Union, will never be likely to feel any bias inauspicious to the principles on which it is founded. How far Congress will exercise this power of legislation must depend upon the state of the country, and such considerations as to the necessity for such legislation as have heretofore, or may hereafter, affect its action. Manifestly, thus far, Congress has never deemed it necessary to exhaust the legislative power conferred upon it by this clause of the constitution. The twelfth section of the Judiciary Act, 1 Statutes at Large, 79, authorized a removal to the Circuit Court of the United States by a defendant, of any suit commenced in a state court against an alien, or by a citizen of the state in which the suit is brought against a citizen of another state, where the matter in dispute exceeds the sum of five hundred dollars. Under this section it was held that a cause could not be removed except upon the petition of all the defendants; that to bring the case within the Act *all* the plaintiffs must be citizens of the state in which a suit is brought, and all the defendants must be citizens of some other state or states. Smith *v.* Rines, 2 Sumner, 338; Hubbard *v.* R. R. Co., 3 Blatchford, 84; Beardsley *v.* Torrey, 4 Wash., 286; Ward *v.* Arredondo, 1 Paine C. C. R., 410; Strawbridge *v.* Curtis, 3 Cranch, 267.

These cases all turned on the construction of the words used in the eleventh and twelfth sections of the Judiciary Act, not on the construction of the clause of the constitution conferring judicial power. As the eleventh section of the Act of Congress,

in prescribing the jurisdiction of the Circuit Court, had limited it to cases "where the suit is between a citizen of the state "where the suit is brought and a citizen of another state," and the twelfth section had limited the right of removal to the Circuit Court to a "defendant in any suit commenced in a state court against "an alien, or by a citizen of the state in which the suit is brought "against a citizen of another state," the courts held these expressions to mean that each distinct interest should be represented by persons, all of whom are entitled to sue, or may be sued in the federal courts. In the language of Ch. J. Marshall: "That "is where the interest is joint, each of the persons concerned "in that interest must be competent to sue, or liable to be sued "in those courts."

The modification of the jurisdiction conferred by the eleventh section subsequently made by the Act of February 28th, 1839, it is not necessary here to consider. Then followed the Act of July 27, 1866, 14 Stat. at Large, 306, entitled, "An Act for the "removal of causes in certain cases from the state courts." This Act applies to suits "commenced in a state court against an alien, "or by a citizen of the state in which the suit is brought against "a citizen of another state." It contemplates suits in which the plaintiff is a citizen of the state in which the suit is brought, and in which there are several defendants, some residing in the state in which the suit is brought, and some either aliens or citizens of a state other than that in which the suit is brought. "If the "suit, so far as relates to the alien defendant, or to the defendant "who is the citizen of a state other than that in which the suit "is brought, is, or has been, instituted or prosecuted for the pur- "pose of restraining or enjoining him, or if the suit is one in "which there can be a final determination of the controversy, so

"far as it concerns him, without the presence of the other defend-
"ants as parties in the cause, then, and in every such case, the
"alien defendant, or the defendant who is a citizen of the state
"other than that in which the suit is brought, may at any time
"before the trial or final hearing of the cause, file a petition for
"the removal of the cause, *as against him*, into the next Circuit
"Court of the United States to be held in the district where the
"suit is pending." Upon the filing of this petition, and giving the security required by the statute, the state court is to proceed no further in the cause, *as against the defendant so applying* for its removal. But "such removal of the cause, as against the "defendant petitioning therefor, into the United States Court, "shall not be deemed to prejudice or take away the right of the "plaintiff to proceed at the same time with the suit in the state "court, as against the other defendants, if he shall desire so to do." Before the passage of this Act no removal could be made in the causes to which the Act applies, because *all* the defendants were not entitled to petition for removal, and the courts had decided that unless it was removable as to *all* it was not so to any. After the passage of the Act of 1866, in certain cases the alien, or non-resident defendant, could have the cause removed as to him, while it was allowed to proceed in the state courts as to the resident defendants. But as in the Judiciary Act, the right of removal was limited to the alien, or non-resident defendant, and does not extend to the plaintiff.

Next followed the Act of March 2, 1867, 14 Stat. at Large, 558, upon which the right of removal in this case is claimed. This Act provides, "that where a suit is now pending, or may "hereafter be brought in any state court *in which there is a con-*
"*troversy* between a citizen of the state in which the suit is

"brought and a citizen of another state;" * * * "such citi-
"zen of another state, *whether he be plaintiff or defendant*, if he
"will make and file in such state court an affidavit stating that
"he has reason to believe, and does believe, that from prejudice
"or local influence, he will not be able to obtain justice in such
"state court," may have the cause removed to the Circuit Court of the United States. This Act purports to be an amendment of the Act of July 27, 1866. It differs from all previous legislation of Congress upon the subject of removal of suits in this respect; the previous acts referred to "suits between citizens of different "states," which expression the courts had construed to be limited to suits in which all persons constituting the party plaintiff were citizens of other states than those of which all the persons composing the party defendant were citizens, as we have before seen. The Act of 1867, for the first time, uses the broader expression of the *constitution*, and refers to suits "in which there is a *contro-*
"*versy* between a citizen of the state in which the suit is brought "and a citizen of another state." It differs also from the prior Acts in relation to removal, by using, as to the plaintiff, the language of the eleventh section of the Judiciary Act instead of the language of the twelfth. The plaintiff may or may not be a resident of the state in which the suit is brought, and the right of removal of the suit is given to the non-resident citizen, be he plaintiff or defendant. The change of the form of expression from suits between citizens of different states to suits in which there is a controversy between a citizen of the state in which the suit is brought and a citizen of another state, was evidently made advisedly, and for the purpose of extending and enlarging the right of removal, not of limiting it, as would be the effect if the construction contended for were admitted. The only conditions

requisite to the right of removal under the Act of 1867, are, that in the suit pending in the state court there shall be a controversy between a citizen of the state in which the suit is brought and a citizen of another state; that the matter in dispute shall exceed the sum of five hundred dollars, exclusive of costs; that the citizen of such other state, either plaintiff or defendant, shall make and file the affidavit required by the Statute; and that he shall give the requisite surety for appearing and entering the case in the Circuit Court at the proper time, with the copies of the papers in the case. Johnson *v.* Morrell, 1 Woolworth, 390, Opinion of Mr. Justice Miller; Sands *v.* Smith, 1 Dillon, 290, Opinion of Dillon, U. S. Circuit Judge.

These requisites to the right of removal all exist and have been complied with in the present case. The motion to dismiss for want of jurisdiction is therefore overruled, and the case is to stand for trial.

Delivered August 1, 1873.

Supreme Court of the United States.

THE GROVER & BAKER SEWING MACHINE CO.,
THE WHEELER & WILSON MANUFACTURING CO.,
AND
THE SINGER MANUFACTURING COMPANY,
PLAINTIFFS IN ERROR,

vs.

THE FLORENCE SEWING MACHINE COMPANY.

In Error to the Supreme Judicial Court of the State of Massachusetts.

BRIEF FOR THE DEFENDANT IN ERROR.

E. R. HOAR, } OF COUNSEL.
A. L. SOULE, }

SPRINGFIELD, MASS:
CLARK W. BRYAN & COMPANY, PRINTERS.
1874.

Supreme Court of the United States.

THE GROVER & BAKER SEWING MACHINE COMPANY,
THE WHEELER & WILSON MANUFACTURING COMPANY,
AND
THE SINGER MANFACTURING COMPANY,
PLAINTIFFS IN ERROR,

vs.

THE FLORENCE SEWING MACHINE COMPANY.

BRIEF FOR DEFENDANT IN ERROR.

STATEMENT OF FACTS.

THIS was a suit at law by the Florence Sewing Machine Company, a corporation established under the laws of the State of Massachusetts, against the Grover & Baker Sewing Machine Company, a corporation established under the laws of the State of Massachusetts, the Wheeler & Wilson Manufacturing Company, a corporation established under the laws of the State of Connecticut, and the Singer Manufacturing Company, a corporation established under the laws of the State of New York.

The suit was brought in the Supreme Judicial Court of the State of Massachusetts, to recover back certain moneys alleged to be due from the Plaintiffs in error to the Defendant in error by reason of certain over-payments made by the Defendant in error to the representative of the Plaintiffs in error, as patent rent under an agreement in writing fixing the rate of patent rent and providing for a reduction in the rate in case of the granting by the Plaintiffs in error of any other license for the manufacture of a certain kind of sewing machine

at a less patent rent, Defendant in error alleging in its declaration that the Plaintiffs in error had granted such license for the manufacture of another machine of the specified kind at a less patent rent, and had neglected to inform the Defendant in error thereof, and had continued to demand and receive from the Defendant in error patent rent at the larger rate; and that the Defendant in error, in ignorance of the reduction of the patent rent effected by the granting of such license at a less patent rent, had continued to pay patent rent at the larger rate, and so paying had paid to the Plaintiffs in error, through their representative, a large sum above and in addition to all sums which the Defendant in error was under obligation to pay as patent rent under its said agreement; and that the Plaintiffs in error therefore owed the defendant in error the amount so over-paid, with interest.

The action was duly entered at the April Term, 1871.

The Grover & Baker Sewing Machine Company appeared in the action at the first term, and filed its answer in due time.

The Wheeler & Wilson Manufacturing Company and the Singer Manufacturing Company made special appearance only, at the first term; and an order of notice to them to appear at the September Term, 1871, was issued. At the September Term, 1871, proof of the service of the order of notice, by publication, was duly filed.

The Wheeler & Wilson Manufacturing Company and the Singer Manufacturing Company did not appear, and were therefore in default, jurisdiction having been obtained of them by attachment of property of each of them, on the original writ.

At the April Term, 1872, the Wheeler & Wilson Manufacturing Company and the Singer Manufacturing Company moved for and obtained leave of the Court, with consent of the Defendant in error, to file their respective answers in the case; and on the same day filed their answers, and on the same day filed their several petitions for removal of the suit to the Circuit Court of the United States for the District of Massachusetts, with affidavits purporting to be of their respective presidents, and with their several bonds.

The Court refused the petitions for removal, and tried the case, all the Plaintiffs in error joining in the defence.

A verdict was rendered for the Defendant in error, and judgment was ordered thereon after hearing by the full court of argument on the exceptions alleged by the Plaintiffs in error.

The Plaintiffs in error claim that the State Court erred in refusing the petitions for removal of the suit to the Circuit Court.

The questions arising here are:

1. Does the act of March 2, 1867, 14 Stat. at L., 558 authorize the removal from the State Court of a suit against joint defendants, one of whom, with the plaintiff, is a citizen of the State in which the suit is brought?

2. If the terms of the act are such as to authorize the removal of such action, is the act constitutional?

3. If such removal is authorized by the terms of the act and by the Constitution, did the proceedings of the petitioners for removal meet the requirements of the act, and authorize the removal?

The Defendant in error submits that each of these questions must be answered in the negative.

I.

The act of March 2, 1867, Stat. at large, 558, does not authorize the removal of a cause when the Plaintiff and one of several defendants are citizens of the State where the suit is brought.

It provides for the removal of a suit "in which there is controversy "between a citizen of the State in which the suit is brought and a "citizen of another State," and it applies only to suits in which the controversy is between a citizen of the State in which the suit is brought *and no one else*, on the one side, and a citizen or citizens of another State *and no one else*, on the other side.

This is the only interpretation of the act consistent with the interpretation by this and other courts, of similar language in the Judiciary Act—so called.

Section 11 of the Judiciary Act—Act of September 24, 1789. 1—Statute at Large 73, gives the circuit courts of the United States jurisdiction of all civil suits in which the matter in dispute exceeds five hundred dollars, "between a citizen of the State where the suit "is brought and a citizen of another State."

Section 12 of the same act provides for the removal from the State court to the circuit courts, "if a suit be commenced by a citizen of "the State in which the suit is brought, against a citizen of another "state."

And under both these sections it has been held by many judges of

the circuit courts, and uniformly by this court, that the statute applies only to those cases in which all the individuals making up the plaintiffs are citizens of the State where the suit is brought; and all the individuals making up the defendants are citizens of another State or States.

Strawbridge *vs.* Curtis, 3 Cranch, 267.
New Orleans *vs.* Winter, 1 Wheaton, 91.
Hubbard *vs.* Northern R. R. Co., 3 Blatch, C. C., 84.
Moffat *vs.* Soley, 2 Paine, 193.
Beardsley *vs.* Torrey, 4 W., C. C., 286.
Com. etc., *vs.* Slocum, 14 Pet. 60.
Irvine *vs.* Lowry, 14 Pet. 293.
Wilson *vs.* Blodgett, 4 McLean, 363.
Bank *vs.* Willis, 3 Sumner, 472.
Coal Co. *vs.* Blatchford, 11 Wallace, 172.
In re Turner, 3 Wall, Jr., C. C.
In re Girard, 3 Wall, Jr., C. C., 263.

The only difference, affecting the question of interpretation, between the language of those sections and the language of the Act of March 2, 1867, is, that those sections speak of "*suits* between a citizen of "the State where the suit is brought and a citizen of another State," while the Act of 1867 speaks of "a suit in which there is controversy "between a citizen of the State in which the suit is brought and a "citizen of another State," and it is difficult to find any principle on which it can be held, that the words "between a citizen of the State in which the suit is brought and a citizen of another State," mean anything in the statute of 1867, which it has been so often decided that they do not mean in the Judiciary Act.

It would seem to be clear that language used so long ago in a statute, and construed so many times by the court, *must*, when introduced into a new statute, be construed in the same way in which it had always been construed before;

And that "controversy between a citizen of the State where the "suit is brought and a citizen of another State," must mean "con-"troversy between individuals all of whom are citizens of the State "where the suit is brought, on the one side, and individuals all of "whom are citizens of another State or States, on the other side."

And this has been held to be the true interpretation of the Act of 1867, in numerous cases, both by State Courts, and by Circuit Courts of the United States.

Cook *vs.* State Nat. Bank, 1 Lansing (N. Y. Sup. Ct.) 494.
Peters *vs.* Peters, 41 Georgia, 242.
Bliss *vs.* Rawson, 43 Georgia, 182.
Ex parte Andrews, 40 Alabama, 238.
Dart *vs.* Walker, (N. Y. C. C. P.,) 43 Howard Pr., 29.
Bryant *et al. vs.* Scott, 67 North Carolina, 391.
Beery *vs.* Irick, 22 Grattan, (Va.,) 484.
Bryant *vs.* Rich, 106 Mass., 180.
Hazard *vs.* Durant, 9 R. I., 602.
Cook. *vs.* State Nat. Bank, 52 N. York, 96.
Bixby *vs.* Couse, 8 Blatch, C. C., 73.
Case *vs.* Douglass, 1 Dillon, C. C., 299.
Waggener *vs.* Cheek, *et al.*, 2 Dillon, C. C., 560.

The Plaintiffs in error claim, however, that the Act of 1867 was intended to enlarge the power of removal so that in any case when some of the individuals Plaintiff, and some of the individuals Defendant are citizens of the State where the suit is brought, and one of the individuals Plaintiff or Defendant is a citizen of another State, he may remove the suit to the Circuit Courts of the United States.

The only decisions known to the counsel for the Defendant in error, supposed to sustain the position of the Plaintiffs in error, are those of judges of Circuit Court of the United States in

Johnson *vs.* Morrill, 1 Woolworth 390,
Sands *vs.* Smith, 1 Dillon, 290,

and the decision of Mr. Justice Shepley in the district of Massachusetts in

Florence S. M. Co. *vs.* Grover & Baker Sewing Machine Co., *et al.*

But it is to be observed that in the case decided by Mr. Justice Miller,—Johnson *vs.* Morrill,—the action was brought by one Plaintiff, a citizen of Iowa, against a Defendant, a citizen of Nebraska, who appeared, and a Defendant, a citizen of New York, who was not

served and did not appear. The action proceeded against the party appearing, as sole Defendant, and no question arose as to the application of the Statute to a case where the Plaintiff and a part of the individuals making up the Defendants are citizens of the same State. And the enumeration of the requisites to the right of removal is made by the learned Judge, without reference to that question.

In Sands *vs.* Smith, 1 Dillon 290, the Plaintiff was a cizizen of New York, one of the indivi uals defending was a citizen of Missouri; all the others were citizens of Nebraska.

The removal to the United States Court was sustained on the ground that "as against the Nebraska Defendants if sued alone, the "right of removal could have been maintained, and as to the other, "*the suit might have been brought under the Act of* 1839 *against* "*them all together in the Circuit Court*, that the action was on a "joint and several note." And that the Missouri citizen "*was de-*"*prived of no right by holding in favor of the removal.*"

This language foreshadows the opinion of the learned Judge who used it, that the removal could not be sustained in any case which could not originally be brought in the Circuit Court, by reason of the citizenship of the parties, which opinion is clearly announced in Case *vs.* Douglass, reported in the same volume (1 Dillon 299); which was remanded to the State Court because it did not appear that *all* the Plaintiffs (who were partners) were citizens of Nebraska; the Court saying, "for aught that is shown *one of them may be a citi-*"*zen of the same State with the Defendants.* The case is distin-"guishable from Sands *vs.* Smith, where the right of removal given "by the Judiciary Act was held to be appealed by the Act of Feb. "28, 1839, and of July 27, 1866, in relation to Defendants."

The decision of Mr. Justice Shepley coincides fully with the position of the Plaintiffs in error.

It seems to be based on the idea that the introduction into the Act of the phrase "a suit in which there is controversy between, &c.," indicates a purpose to extend the right of removal to a class of cases not reached by the phrase "a suit between, &c.," and on the further idea that the opinions in Johnson *vs.* Morrill and Sands *vs.* Smith already referred to, sustain that view.

We have already seen that there is nothing in either of those cases to warrant such conclusion.

What does the phrase "a suit in which there is controversy between, &c.," mean?

The word "controversies" is taken from the Constitution, Art 3 §2, which provides that "the Judicial power shall extend to all cases, in "law and equity, arising under the constitution, the laws of the "United States, and treaties, etc.; to controversies to which the "United States shall be a party; to controversies between two or "more States; between a State and citizens of another State; between "citizens of different States; between citizens of the same State "claiming lands under grants of different States."

As thus used, the word is a general term, broad enough to cover all branches and technical forms of litigation, being equivalent to "suits or cases at law and in equity."

It cannot have any other meaning or force than as a designation of judicial proceedings, whether those proceedings be called suits, actions, petitions or bills in equity.

Says Chief Justice Marshall, in Osborne *vs.* U. S. Bank, 9 Wheaton, 319, "That power (the judicial power) is capable of acting "only when the subject is submitted to it by a party who asserts "his rights in the form prescribed by law. It then becomes a case."

We submit that there is no "controversy" known to the judicial power under the Constitution, except the case or suit which is instituted according to the forms prescribed by law. And that therefore the phrase "suit in which there is controversy between" is equivalent to the phrase "suit between." Any other interpretation would involve the idea that the Courts of the United States have jurisdiction in controversies between parties outside of and apart from the suits which are in those Courts.

To give to the word "controversy" in the Act a meaning different from, broader, or more popular, than that which the word "controversies" manifestly has in the Constitution, would be to attempt to give to the Courts of the United States, by Statute, a wider jurisdiction than the language of the Constitution authorizes.

If we are right in the interpretation of the words of the Act, it results that the meaning and effect of the Act has already been settled by the construction given, in the cases above cited, to section eleven and twelve, of the Judiciary Act.

But it is claimed that this cannot be so, because the Act of 1867 is an amendment of the Act of July 1866, (14 stat. at large 306,) which provides for the removal of suits, in which the Plaintiff and a part of the Defendants are citizens of the State in which the suit is brought.

Undoubtedly the title of an Act is of value in determining what is its purpose and effect. But it is not to be used to wrest the language of the amendatory Act, to a meaning contrary to that which has been given by judicial authority to language substantially the same, in former Acts.

And it is manifest on reference to the title of the Act of 1866, that no such strained construction is necessary to satisfy the call of the title of the Act of 1867.

The Act of 1866 is entitled "An Act for the Removal of Causes in certain cases from State Courts." An Act in amendment thereof may be in effect, an Act for the removal of other causes in certain cases, quite as well as an Act to remove the same causes in certain other cases.

And the Act of 1867 has as real and as wide an operation if construed as the Defendent in error claims that it should be construed, as it would have if construed as applying only to the class of cases described in the Act of 1866, indeed a much wider operation.

The Act of 1866 applies only to two classes of suits; one in which an alien and a citizen of the State where the suit is brought are defendants; the other in which the Plaintiff and a part of the Defendants are citizens of the State in which the suit is brought. And in order to the removal in either class requires the interests of the two kinds of defendants to be several and distinct.

Now if the act of 1867 is construed to be merely a provision for removing suits of these classes, only, as to all the defendants, instead of as to a part, its operation is confined to a very narrow field.

If, however, it is construed to apply to the removal of suits, where the whole plaintiff or whole defendant has citizenship in the State when the suit is brought, and the whole opposing party has citizenship in another State, the number of suits which it would reach would probably be much larger than under the other construction.

There is no power, then, in the argument that the interpretation contended for by the Defendant, in error, would make the Act inoperative.

On the contrary; as understood by the Defendant in error, the Act of 1867, works a large addition to the power of removal.

The Judiciary Act, § 12, provided for a removal at the time of entering appearance, by the whole party defendant, citizen of another State, the whole party plaintiff being citizen of the State in which the suit is brought.

The Act of 1866, provides for a partial removal at any time before final hearing or trial, when the interest of the defendants is separate and distinct, on petition of an alien Defendant, if a part of the Defendants are citizens of the State where the suit is brought, whereever the Plaintiff may have citizenship; and on petition of a Defendant, citizen of another State, where the Plaintiff, and a part of Defendants, are citizens of the State where the suit is brought.

The Act of 1867 provides for the removal, at any time before trial or final hearing, of the whole suit by the whole of either plaintiff or defendant, citizen of another State, when the whole of the adverse party has citizenship in the State where the suit is brought;

Being the first provision made for removal of suit by a plaintiff.

Moreover, to adopt the construction of the Act of 1867, contended for by the plaintiffs in error, would be to introduce a singular anomaly.

It would give to the Circuit Courts of the United States jurisdiction in a large class of cases originally brought in State Courts, in which they would have no jurisdiction if originally brought in the Circuit Courts;

And it cannot be supposed that it was the purpose of the Act to extend and enlarge the jurisdiction of the Courts by indirection.

There is no analogy between the question here and that decided in Osborne *vs.* The United States Bank, 9 Wheaton, 738. In that case, Chief Justice Marshall held that, inasmuch as the bank was chartered by the United States, with specified powers and rights, and the question on which the case arose was a question as to its powers and rights, the grant in the charter of the right to sue in the Circuit Courts was within the provision of the constitution which extends the judicial power to all cases arising under the laws of the United States;—and that the fact that

other questions *might* arise in the progress of the case did not oust the Court of its jurisdiction. The Chief Justice says:

"The Act does not stop with incorporating the bank. It pro-"ceeds to bestow on the being it has made all the faculties and "capacities which that being possesses. Every act of the bank "grows out of this law, and is tested by it. To use the language "of the constitution, every act of the bank arises out of this law."

The jurisdiction depended on the subject matter of the suit, and the case conld not have arisen except under the laws of the United States.

In Fisk *vs.* The Union Pacific Railroad Company, 8 Blatch, 243, which is sometimes cited as an authority for the construction of the Act contended for by the Plaintiffs in error, it does not appear that there were any defendants other than those to whom the right of removal was given by the statute. On the contrary, it affirmatively appears that all the defendants made petition for the removal, the inference from which fact is that they were all entitled by the statute to do so. The remarks, therefore, of the learned judge who gave the opinion of the Court, as to the effect of joining "outside" parties as defendants, are mere *dicta* not called for in the case, and forming no part of the grounds of decision.

II.

If the Act of 1867 is construed as authorizing the removal of suits in which the Plaintiff and a part of the individuals making up the party Defendant are Citizens of the State where the suit is brought, the Act is, in that regard, unconstitutional.

It provides for removing the suit, as to all the parties, to the United States Court, and that after the petition is filed, with proper surety and the proper affidavit, it shall be the duty of the State Court to proceed no farther in the suit.

This construction presupposes a jurisdiction in the United States Courts of controversies between Citizens of the same State;

And a power to oust the State Courts of jurisdiction in controversies between its own citizens, at the request of citizens of another State; and even against the will of both Plaintiff and those of the Defendants who are citizens of the State where the suit is brought.

We say "controversies" between citizens of the same State, because this construction of the Act, can be maintained only on the ground that in it, the word "controversy" is used in another and more popular sense than that in which it is used in the Constitution.

The Constitution provides for jurisdiction in the United States Courts in a few great classes.

First, in *all* cases arising under the Constitution, the laws of the United States, and treaties.

Second, in *all* cases *affecting* ambassadors, other public ministers and consuls.

Third, all cases of admiralty and maritime jurisdiction.

Fourth, controversies in which the United States shall be a party.

Fifth, controversies between States.

Sixth, controversies between a State and citizens of another State.

Seventh, between citizens of different States.

Eighth, between citizens of the same State, claiming lands under grants of different States.

Ninth, between a State or the citizen thereof, and foreign States, citizens or subjects.

In the first, second, third and fourth of these classes, the jurisdiction in no wise depends on the citizenship of individuals.

The fifth class relates only to States.

The sixth class relates only to controversies in which a State is a party.

In the seventh class the jurisdiction depends entirely on the citizenship of the parties.

In the eighth, on the subject matter of the controversy.

In the first three classes, citizens of the same or of different States may be both plaintiffs and defendants.

In the fourth class, citizens of the same and of different States may be joined together in the same party to the controversy.

But it is submitted that in the *seventh* class, the individuals on one side of the controversy must all be citizens of the State in which the suit is brought; on the other, all citizens of another State or States.

As we have already seen, "the judicial power under the Constitu- "tion is capable of acting only when the subject is submitted to it "by a party who asserts his rights in the form prescribed by law," that is to say, in a suit of some kind.

The suit is the "controversy" contemplated by the Constitution.

And in order that the United States Courts may have jurisdiction, the suit, if the interpretation of the Constitution is to be consistent with the interpretation already and repeatedly given to the judiciary act, must be between citizens of one State, and no one else, on the one side, and citizens of other States, and no one else, on the other side.

Nor does this interpretation of the clause in question impair the end which it was designed to attain.

It leaves uninterfered with, the power to legislate as to all the cases which come fully within the language of the clause—as to all controversies which are fully and completely described as being between citizens of different States.

Nor is it to be inferred that the word "controversies" is used in this clause in any other sense than that which is here contended for, from the fact that it is used in a different sense by the legislative branch of the government in 1866 or 1867.

The meaning of the constitution is not dependent on subsequent Acts of Congress. But those Acts are operative or invalid as they accord with or violate the provisions of the Constitution.

Nor should the clause be given a wider and larger operation than

its language naturally imports, under the assumption that the construction contended for by the defendant in error, impairs the end which it was designed to attain.

It is said that the clause in question had for its end to protect citizens of different States from danger of injustice in the State Courts through local influence or prejudice; and that viewed as a permanent grant of power to legislate, the end *may be* seriously impaired if the power to legislate is arrested merely by the joinder of other parties.

But, *non constat*, that it was the intention of the constitution to throw this protection over citizens suing or sued in another State than their own, when citizens of the State where the suit is brought, are suing or sued with them. To assume that this is the intention of the constitution is to beg the question. And there is no reason why such should be the intention of the constitution.

The danger to be avoided, exists only when all the individuals on one side of the suit are citizens of the State where the suit is brought, and all the individuals on the other side are citizens of another State. When citizens of the State where the suit is, are on both sides in the suit, the local prejudice or influence is destroyed, balanced, favors one side as much as the other.

When it is remembered that the powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people, it seems clear that the construction of the clause in question by the Plaintiffs in error is erroneous.

That clause does not purport to extend the judicial power of the United States to controversies between citizens of the same State and it is only by claiming that when there are Defendants citizens of the same State with the Plaintiff in a suit, they must be regarded as merely incidental parties, that the clause can be held broad enough to reach the case at bar.

It is plain, however, that the suit is just as much a controversy between citizens of the same State, as it is a controversy between citizens of different States. The interest of the Defendants is joint and inseparable. The Defendant, citizen of the State, is no more *incidental* to the controversy, than the Defendants, citizens of another State. There seems to be no principle, nor rule under which the suit can be described, as a controversy between citizens of different States.

If the meaning of the clause in question were at all doubtful in itself, it is made clear by the clause which immediately succeeds it, and which specifies the cases in which the judicial power shall extend to controversies between citizens of the same State, being the *eighth* class in the enumeration hereinbefore given.

It can hardly be supposed, in view of the existence of the clause last referred to, that the clause in question has the meaning claimed by the Plaintiffs in error.

Expressio unius exclusio est alterius.

III.

The parties making petitions for removal of the suit did not comply with the requirements of the Act.

1. If the case was removable it must have been so on the joint petitions of the citizens of another State; it could not be removed on the petition of either alone.

Smith *vs.* Rines, 2 Sumner, 338.

Beardsley *vs.* Torrey, 4 W. C. C., 286.

The petition of the Wheeler & Wilson Company was its separate petition, and therefore inoperative.

Record, p. 15.

The petition of the Singer Company was its separate petition and therefore inoperative.

Record, p. 18.

They cannot be joined by the Court so as to aid each other.

2. There is no affidavit of either petitioner in support of its petition.

The only affidavit filed in support of the petition of the Wheeler & Wilson Company, is the affidavit of Nathaniel Wheeler, describing him as president of the Company.

Record, pp. 14, 16.

It does not purport to be the affidavit of the Company, but merely an "affidavit on behalf of the Wheeler & Wilson Manufacturing Company." It does not purport to be made by direction of the Company, nor with its consent.

The only affidavit filed in support of the petition of the Singer Manufacturing Company, is the affidavit of Inslee A. Hopper describing him as President of the Company.

Record pp. 18, 20.

It does not purport to be the affidavit of the Company, but merely an "affidavit on behalf of the Singer Manufacturing Company."

It does not purport to be made by direction of the Company, nor with its consent.

Neither affidavit contains any sworn statement that the person making it is the President of the Company on behalf of which the affidavit is made.

Now the Act requires that the citizen petitioning shall make and file an affidavit. And it has been held that this affidavit cannot be made on behalf of the citizen by an attorney, and that a corporation being unable to make an affidavit, is incapable of removing a suit, and that even the petition is fatally defective if signed by attorney.

Kilpatrick *vs.* Hopkins, 2 Miles, (Pa.,) 277.
Dodge *vs.* Northw. Packet Co., 13 Minn., 458.
Cook *vs.* State Nat. Bank, 52 N. Y., 96.

3. The affidavits are both fatally insufficient in substance, even if made by competent persons, because neither of them contains any statement that the petitioning citizen has reason to believe, or does believe, that from prejudice or local influence, it will not be able to obtain justice in the State Court.

The only averment in the affidavit, on behalf of the Wheeler & Wilson Company, is that Nathaniel Wheeler has reason so to believe, and does so believe.

Record, pp. 14–16.

The only averment in the affidavit, on behalf of the Singer Manufacturing Company, is the averment that Inslee A. Hopper has reason to believe, and does so believe.

Record, pp. 18–20.

But the Act requires the affidavit of the citizen that *he*—in the case at bar, the *Corporation*—has reason so to believe, and does so believe.

And though it be held that the reason to believe and belief of the Corporation may be sworn to by an officer, agent, or attorney, and be operative to effect the removal sought, it would seem that without any affidavit of such belief there can be no removal.

The personal opinion or belief of one officer of a Corporation, is by no means necessarily the opinion or belief of the Corporation. That officer may differ in opinion and belief, on the point, from every other officer or stockholder connected with the Corporation.

Suppose the Treasurer or Secretary of the several Corporations had

filed his affidavit purporting to be made on behalf of his Company, averring that he had reason to believe, and did believe, that his Corporation would be able to obtain justice in the State Court, despite prejudice and local influence; which affidavit would be a statement of the belief of the Corporation? Both? or neither?

The affidavit of the attorney of the petitioner, that the petitioner had reason to believe, etc., has been held insufficient.

Sands *vs.* Smith, 1 Dillon, 298 *note*.

Much more is the affidavit of the officer of the petitioner, that *he*, not the petitioner, has reason to believe, &c., insufficient.

The petitions for renewal both recognize the necessity of the averment that the petitioning citizen has reason to believe, and does believe, &c., and both contain the averment.

Record, p. 15, folio 57.
Record, p. 19, folio 72.

Would the petitions have been good, if they contained only averments that Wheeler and Hopper had reason to believe, and believed, &c.?

And is it not significant that the same persons who signed the petitions of their respective corporations containing the proper averment,—not under oath,—refused to incorporate that averment into their respective affidavits?

4. The Act requires the petitioner to offer good and sufficient surety for his entering in the next Circuit Court of the United States to be held for the district in which the suit is pending, on the first day of its session, copies of the process, &c.

Neither petitioner offered surety for its so doing.

The surety they offered was by way of bond filed—each of the petitioners filing its separate bond with sureties.

The condition is the same in both, as follows: "that the said" (the principal) "shall enter or cause to be entered in the Circuit "Court af the United States, to be held at Boston, within and "for the District of Massachusetts, on the first day of its stated session next ensuing *after the order of the said Supreme Judicial "Court for the removal of said suit into said United States Court "copies," &c.*

Record, p. 17, fol. 66; p. 21, fol. 80.

This condition is not substantially the same with that required by the Act.

It leaves it uncertain at what term the entry must be made in the Circuit Court, to satisfy the condition; but the Act says the surety must be for making the entry at the next term after the petition is filed.

No order for removal was necessary. If the suit was removable, and the proceedings of the petitioners and their papers regular, the filing of the papers effected the removal, without any action or order of the State Court.

Fisk *vs.* Union Pac. R. R., 6 Blatch 362.
Hatch *vs.* R. I. and Pac. R. R., 6 Blatch 105.

No order for the removal of the suit has been made by the State Court.

On the contrary, the removal was refused.

No action could be maintained on either of the bonds. There can never be a breach of the condition till the State Court shall make an order to remove the suit.

Meanwhile, if the suit is held to have been removed, the time to enter the copies, &c., in the Circuit Court under the Act, has long since passed.

If the copies were not entered, where would be the remedy for the Defendant in error?

Even if a subsequent refusal of the Court to grant the petition for removal, can be tortured into an order *for* the removal of the suit, the bonds are not the bonds required by the Act. They were to be judged by the existing state of things when they were filed. If they were not sufficient *then*, no subsequent events could make them so.

It has always been held that a strict compliance with the requirements of acts for the removal of suits, is essential to the right to remove.

Darst *vs.* Bates, 51 Illinois, 448.
Bell *vs.* Dix, 49 New York, 236.
Holden *vs.* Putnam Fire Ins. Co., 46 New York, 1.

And there is nothing in the situation of the Plaintiffs in error which entitles them to any relaxation of the strictness of the law, if the matter were in the discretion of the Court.

Already in default by failing to appear, the two petitioners for removal obtained leave of the Court, on motion, with consent of the Defendant in error, to file their answers, notwithstanding. And took advantage of this favor of the Court and the Defendant in error, to file their petitions for removal.

Record, p. 10, fol. 37, 38; p. 11, fol. 43; p. 12, fol. 44 45; p. p. 15, 18.

If it is possible for parties to waive the right of removal, as has been held by some courts,

Glens' Falls Ins. Co., *vs.* Judge etc., 21 Mich. 578,

the Plaintiffs in error should be held to have waived their right, by making default, and obtaining by favor the right to come in and answer.

E. R. HOAR,
A. L. SOULE,
Of Counsel for the Defendant in Error.